SUPREME COURT, U. S.

Supreme Court, U.S.
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IN THE

Supreme Court of the United States

OCTOBER TERM, 1971

Docket No. 71-449

VAN MARK PRODUCTS CORPORATION and
EUGENE VAN CLEAVE,
Petitioners,

vs.

TAPCO PRODUCTS COMPANY,
Respondent.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SIXTH CIRCUIT

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Petitioners respectfully pray that a Writ of Certiorari issue to review the Judgment entered on July 12, 1971 of the United States Court of Appeals for the Sixth Circuit in its cause, numbered 20,835.

I. OPINIONS BELOW

The Opinion of the Sixth Circuit Court of Appeals in this cause is set forth in the Appendix to this Petition commencing at page 1(a). It has not been officially reported, as of this moment.

A Petition for Correction of the Opinion and for a Rehearing was filed, but was denied by an Order of the Court dated August 30, 1971 (see Petition Appendix, p. 19a). Such order was not reported.

The Opinion of the District Court is set forth in the Appendix to this Petition, commencing at page 23a. It has been officially reported at — F. Supp. —, and also at 166 USPQ 530.

II. GROUNDS FOR THIS COURT'S JURISDICTION

The Judgment sought to be reviewed was dated and entered on July 12, 1971. Petitioners filed a timely Petition for Correction of Opinion and Rehearing, which was denied by an Order dated August 30, 1971 (19a).

The United States Code, Title 28, Section 1251(1), confers on this Court jurisdiction to review the Judgment in question by Writ of Certiorari.

III. QUESTION PRESENTED

Did the Court of Appeals, in reversing the District Court's Finding of Fact that the flat top hinge of the patented bending brake functioned no differently from the round top hinge of the prior art bending brake, violate Rule 52(a) of the Federal Rules of Civil Procedure, which rule restricts an Appellate Court from reversing a Finding of Fact of the Trial Court unless clearly erroneous.

IV. THE RULE INVOLVED

The relevant portion of Rule 52(a) F.R.C.P., provides that:

> "Findings of Fact shall not be set aside unless clearly erroneous, and due regard shall be given the opportunity of the Trial Court to judge of the credibility of the witnesses."

V. STATEMENT OF THE CASE

The Opinions below relate to the issue of validity of the Marsh Patent No. 3,161,223, issued December 15, 1964, relating to a Sheet Metal Brake, and assigned to the Respondent herein.

More specifically, the opinions relate to a contention that the flat top hinge of the patented bending brake functions differently from the round top hinge of the prior art bending brake, in the matter of providing full support to the sheet metal being bent during the bending operation.

The District Court personally observed the bending operations of the patented and prior art brakes and found that there was no new function or new result, and held the patent to be invalid for obviousness. More specifically, the District Court personally observed that at no time did the flat-top hinge of the patented brake support or engage the sheet metal during bending of the metal. Hence, it functioned no differently than the round top hinge of the prior art brake which the District Court also observed.

The actual bending operation consists solely of manually lifting a handle upwards. Such handle is on a drop "leaf" which swings up, engaging a piece of sheet metal previously clamped in the brake, and bending the sheet metal upwards. The brake works only one way, no matter who lifts the handle.

The Sixth Circuit Court of Appeals seems to have objected to the fact that the Trial demonstration of the brakes (meaning lifting the bending leaf handle) was performed by Defendant's counsel. The Court of Appeals seems to have ignored Plaintiff's counsel's express statement to the Trial Court that: "We have no objection, your Honor" (Appeal Appendix, p. 261) to Defendant's counsel conducting the Trial demonstration. Without ever having seen the brake or its operation, the Court of Appeals set aside the District Court's Finding of Fact.

The Court of Appeal's Finding that the flat-top hinge supports the sheet metal during bending, and particularly at the full bending (meaning approximately 90°) is not only mistaken, but is physically impossible. Additionally, the Court of Appeal's Finding, that during the Trial Court demonstration the brake was not operated to perform a full 90° bend, was based entirely upon a later "unsworn, self-serving statement" of Plaintiff's counsel, who upon

making that statement to the Court after the demonstration, was asked to repeat the demonstration himself to avoid any such challenge as to its validity, but refused to do so (Appeal Appendix, p. 369).

Instead, the Court of Appeals, contrary to the District Court's observations and Finding, found that the flat top hinge supports the sheet metal during bending and particularly "as the bend approached the vertical", and thereby found invention and patent validity based upon this mistaken Finding of Fact of a new function and new result.

In connection with Petitioner's Petition for Correction and Rehearing, the physical brake trial exhibits were shipped to the Court of Appeals with request that the Court look at these and lift the handle itself and see for itself that it is physically impossible for the hinges, whether flat or round, to engage or support the sheet metal during the bending. The Court of Appeals refused to look at the exhibits but nevertheless denied the Petition for correction of the manifestly mistaken fact.

A. Patent in Suit.

The patent-in-suit relates to a hand-operated, sheet metal bending device, called a "brake". A piece of sheet metal, such as aluminum sheet, such as is used for sidings of houses, is manually placed upon a table, with the edge of the sheet metal extending beyond the table edge. Then the sheet of metal is manually clamped in place upon the table by a strip called an "anvil" which presses down against the sheet metal and table top.

To bend the edge of the sheet metal which extends beyond the table, a bending leaf, which is like a drop leaf of a table, is manually lifted or swung up to push the sheet

metal up, so that it bends around the edge of the clamping strip or anvil.

A hinge connects the bending leaf to the edge of the work table upon which the sheet metal is clamped for bending. All of this is old in the prior art (3a).

"The only substantial difference between the two brakes was the hinge", to quote the Court of Appeals (9a). See also p. 4a.

The patentee Marsh testified that originally he had sold the prior art Rauen patent brake which was on the market, and whose hinge was a separate, piano-type round top hinge, secured by screws to the table and to the bending leaf. Later, he found that the screws tended to loosen, causing loosening of the hinge. Thus, upon seeing an integral or one-piece hinge in use elsewhere, he substituted such an integral hinge for the screw-on type prior hinge in order to eliminate the screw loosening problem and thereby provide greater strength.

That is all that he claimed to be his invention. He testified that the only difference between the prior art brake which he had sold and the patented brake was the adoption of the integral hinge in place of the prior screw-on separate piano hinge.

B. Flat-Top v. Round-Top Hinges.

The integral hinge is formed by cutting notches into the edge of the flat table and the flat leaf, to form integral projections between each pair of notches, with the projections of the flat leaf being interfitted with the projections of the flat table. A hinge pin then is passed through aligned holes in the aligned interfitting projections. The upper surfaces of the hinge projections are flat, because

they are cut out of the flat top table and leaf. Such flat top integral hinges were old.

The District Court found that the mere substitution of an old integral hinge for the separate hinge was dictated by the prior art and was obvious. The Court of Appeals agreed with this finding (13a-14a).

This Court, however, then found that there was a new function and "unsuspected results" arising because of the flat top shape of the hinges, finding that flat top hinges support the sheet metal during the bending, whereas round top hinges do not. It was that latter Finding of Fact, contra to the opposite finding on the same point by the District Court, which provokes this Petition to this Court.

It is clear that the only basis for the Court of Appeals reversal was its finding that the change in shape of the hinge from round top to flat top, was responsible for a new function. The District Court, who saw the hinges operate, found no new function. The Court of Appeals did not see the hinges operate—yet it found a new function.

Nowhere in the Patent Office record made by the applicant for patent, nowhere in the claim in suit, nowhere in the testimony of the patentee, was there any reference to or a contention that the flat top shape performed the alleged new function, supporting the sheet metal during bending in a manner different from the round top shape of the hinge.

The contention that the flat top shape provides full support during bending surfaced for the first time during the examination of Plaintiff's expert witness, a professor, who testified only from his diagram, later admitted by him to be inaccurate. The Trial Court, who heard and saw that witness, but who also saw the brakes being manipulated, rejected that theory. The Court of Appeals, who saw nei-

ther the witness nor the brakes, disregarded that finding of fact by the Trial Court.

Was it "clearly erroneous" for the Trial Court to rely on what he personally saw, how the hinges functioned, rather than on the speculations of a "professor expert", testifying from a diagram admittedly inaccurate, and unsupported by testimony of the patentee himself, or the record before the Patent Office?

C. The Court of Appeals' Mistaken Findings as to New Function.

During the course of the Trial, Plaintiff's expert witness, Professor Youngdahl, injected a new thought, something which was neither claimed in the patent nor described in the patent specification nor claimed by Marsh during his testimony, namely, that the flat tops of the hinges perform a new function. Youngdahl testified that in his opinion, the flat tops of the hinges fully supported the sheet metal during the bending.

He did not testify from the physical devices. Rather, he testified that his opinion was based upon an out of courtroom test which he himself ran, ex parte, wherein he bent a sheet of metal upon a patented brake and another sheet of metal upon a prior art brake. He explained his opinion to the Court by means of a diagram which he drew upon the blackboard, not by actually operating the brakes which were brought to the Court. On cross-examination, he admitted the blackboard diagram to be incorrect (Appeal Appendix, p. 273). "It was not accurate."

The Trial Judge observed Youngdahl's demeanor during his direct as well as his cross-examination testimony. The Trial Judge had the opportunity to judge of his credi-

bility; and rejected his opinion and his testimony. The Trial Judge chose to rely upon his own personal observation of the operation of the brakes, where it was clearly visible to him that at no time during the bending did either the flat top hinge of the patented brake or the round top hinge of the prior art brake contact the sheet metal. Thus, the Trial Judge rejected Youngdahl's testimony and found as a fact, what he saw with his own eyes, that the flat top hinge operates no differently from the round top hinge; and that there was no new function or result caused by the form or shape or flatness of the hinge.

The Court of Appeals, in disregard of Rule 52(a) F.R.C.P., chose to the contrary, accepting the so-called expert's direct testimony opinion, ignoring his cross-examination testimony, and ignoring the physical exhibits and the personal observations of the Court with respect thereto.

The Court of Appeals mistakenly considered that the hinge might support the metal differently in a bend on a short length of metal than in the bending of a longer piece of metal. The District Judge saw the brakes bend the metal, and he saw no support by the hinge. The Court of Appeals saw no brakes and no bending. Only in its speculations, "might very well be", "could be", etc., did the Court of Appeals suggest a distinction between long and short pieces being bent.

The District Judge had two pieces of conflicting evidence to weigh:

(1) The testimony of a hired expert who testified from a diagram based upon an out of court ex-parte test and admittedly inaccurate.

(2) The Courtroom demonstration, without objection by Respondent, of actual physical devices.

The District Court chose to reject the expert's testimony and to accept what he saw with his own eyes. Such a choice hardly qualifies as clear error, particularly when so regarded by a Court of Appeals who neither heard the testimony, saw the demonstration, nor saw the physical devices, nor looked at them.

D. Claim 7 in Issue.

The Trial Court found all seven of the claims of the patent-in-suit to be invalid for obviousness. On Appeal, Respondent confined itself only to Claim 7, which reads as follows:

> 7. In a brake for bending sheet metal, the combination comprising:
>
> a first member (table) having a flat clamping surface,
>
> an anvil member for clamping a piece of metal against said flat clamping surface on said first member,
>
> a second member (bending leaf) having a flat bending surface,
>
> each of said first and second members having substantially the entire length of the longitudinal edges thereof formed with longitudinally spaced intermeshing integral projections,
>
> each said projection of each said member having a surface thereof lying in the plane of the flat surface of its corresponding member,
>
> said projections having aligned openings therein,
>
> and a hinge pin extending through said integral projections and thereby defining a hinge so that said

second member may be swung relative to said first member to bend said metal about said anvil member.

Nowhere in the Claim, or for that matter in the patent specification, is there any statement to the effect that the hinge supports the sheet metal at any time during the bending. As is seen from looking at the physical exhibits, the patented and prior art brakes, it is apparent that geometrically it is physically impossible for the flat top hinge to support the sheet metal during bending in any manner different from the round top hinge. As soon as bending starts, the metal lifts away from the hinge, equally in one case as in the other.

E. Trial Court's Finding of Fact on Functioning of Hinge.

On the crucial point of novel function, the Trial Court found as a fact, as follows: (30a)

> "However, the Court . . . relies most heavily upon the Courtroom demonstration, which negates Plaintiff's position. The Court personally observed actual physical samples of both a prior art brake and a Marsh patent brake. In both instances, the sheet metal was lifted away from the hinge as the metal was bent, due to the geometric characteristics of the spacing of the brake parts in relation to the metal to be bent."

> "Thus, the Court finds Plaintiff's interpretation of flat, gapless hinge projections providing additional support and producing more uniform bend to be unsupported in fact and therefore the Court finds Defendant's interpretation of the claims to be the proper one."

At this point, it may be noted again that the patent claims in suit say nothing about a flat top hinge providing support for the metal during bending.

The Court of Appeals reversed the above finding, without having seen Plaintiff's expert witness, without having seen the physical devices, and without having looked at any demonstrations of the same.

Going one step further, the Court of Appeals has even held that Petitioners, having copied the patented commercial brake, are barred from even pointing out that hinge support of the sheet metal is impossible, as the Court of Appeals mistakenly found, on the grounds that one who copies a commercial device is foreclosed from challenging utility.

VI. REASONS FOR GRANTING THE WRIT

We respectfully submit that the Court of Appeals, in our view, deviated from acceptable judicial practice in disregarding Rule 52(a), thus requiring supervisory action by this Court. It seems to us that the Court of Appeals, without any "clearly erroneous" basis, reversed the District Court's Finding of Fact and found as a fact something which is physically impossible, and not only refused to correct the error upon which it based a finding of validity, but refused even to look at the physical exhibits which make the error manifest.

Rule 52 enjoins a Court of Appeals from setting aside a Finding of Fact unless "clearly erroneous" and requires a Court of Appeals to give "due regard to the opportunity of the Trial Court to judge of the credibility of the witness." We submit that this rule was twice disregarded in this case by the Court of Appeals. Only this Court has the supervisory power and jurisdiction to set aside such action by a Court of Appeals which in our view was in disregard of Rule 52(a).

Here, the Court of Appeals reached its conclusions on the functioning of the brakes, without seeing any brakes, without seeing them operate, and reversed the District Court who did see the brakes and who did see them operate and who concluded, based upon what he saw, that there was no difference in function.

Likewise, the Court of Appeals did not see or hear the witness; the District Court did. The District Court chose to disregard the testimony of the witness. The Court of Appeals chose to accept his *direct* testimony only, seemingly in disregard of the Rule 52 requirement that it give due regard to the opportunity of the District Court to judge of the credibility of the witness.

The Court of Appeals also held that Petitioners are barred from challenging utility of the patented device because Petitioners copied the device. If there is indeed such a rule applicable to this case, then it ought to be abolished, just as *Lear v. Atkins,* 395 US 653 abolished the estoppel against licensees challenging the validity of a patent. As in *Lear,* who else but an alleged copier would have the economic interest in proving patent invalidity, for whatever the reason, including lack of utility, with the public benefiting from the removal of scarecrow patents from the marketplace.

However, this point need not be considered in this Petition, since Petitioners do not challenge the increased strength utility of the patented brake, having adopted the integral hinge for the same reason that the patentee adopted it, namely, it is stronger and eliminates the problem of loosening screws on a separate screwed on hinge. Flatness of the tops of the hinge projections comes about simply because they are cut out of a flat top table and leaf edge. Thus, the challenge here has been only to the contention of new function or new results, namely, that the flat top hinge supports the metal during bending, which function is nei-

ther true nor possible as is evident upon observing a physical brake. We do not deny that the brake has utility. It bends metal, and that utility is admitted.

However, we do deny that the flat top hinge functions differently from the round top hinge. We do deny that the flat top hinge fully supports the metal during its bending. We do deny that precise and specific claim of utility.

VII. CONCLUSION

Since a holding of validity of a patent is a matter of paramount and important public interest, a Writ or Certiorari should be granted on the issue of alleged novel functioning of the patented brake.

Alternatively, this case should be remanded to the Court of Appeals with an Order that the Court of Appeals either look at the exhibits (the physical brakes) and observe the operation of their hinges and *then* reconsider its Finding that there is a new function or result, or that the Court of Appeals remand the case to the Trial Court for more detailed Findings as to function and results of the hinges.

We respectfully submit that if the Court of Appeals chooses to substitute its own Finding for that of the Trial Court as to how the hinges operate, it should at least look at them and see their operation, as the District Court did.

Respectfully submitted,

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APPENDIX

NO. 20835

IN THE

United States Court of Appeals

FOR THE SIXTH CIRCUIT

TAPCO PRODUCTS COMPANY, *Plaintiff-Appellant,* v. VAN MARK PRODUCTS CORPORATION and EUGENE VAN CLEAVE, *Defendants-Appellees.*	APPEAL from United States District Court for the Eastern District of Michigan, Southern Division.

OPINION

Decided and Filed July 12, 1971.

Before WEICK, PECK and McCREE, Circuit Judges.

WEICK, Circuit Judge. The suit in the District Court was for infringement of the Marsh Patent No. 3,161,223, issued December 15, 1964, on a sheet metal brake,[1] which patent had been assigned to Tapco. Appellee Van Cleave had been in the employ of Tapco when the brake was being developed. After leaving Tapco's employ he organized appellee Van Mark Products Corporation and commenced to produce a brake almost identical with the patented brake.

[1] "Brake" is the term used for a machine that bends sheet metal. The patented device was used principally for bending aluminum sheets to be used for siding, windows and doors of houses.

Tapco sued the appellees in the Circuit Court of Wayne County, Michigan, for unfair competition and appropriation of trade secrets. The suit was settled by Van Mark taking a non-exclusive license under the Marsh patent, which provided for a royalty to Tapco of 5-½%, with $10,000-pre-payment of royalties. Thereafter Van Mark did not comply with the royalty provisions of the license agreement and Tapco gave notice of termination and instituted the present action in the District Court for infringement of patent, unfair competition, and causes of action under the license agreement.

By agreement of the parties, the District Court heard only the patent infringement claim. After hearing the evidence the Court handed down an opinion holding that the patent was invalid. 318 F. Supp. 79. Tapco appealed.

The Marsh patent discusses the prior art and the objects of the invention, as follows:

> "It has heretofore been suggested that a brake for bending and forming sheet metal such as aluminum coil stock may comprise a pair of members which are hinged to one another by a hinge such as a piano hinge having the leaves thereof fixed to the respective members. In the construction of such a brake in substantial length so that long lengths of sheet metal can be bent and formed, a major problem is that extreme difficulty is encountered in aligning the hinge leaves with respect to the longitudinal edges of the first and second members. This inaccuracy not only results in an improper bend but, in addition, mars the surface of the sheet metal where it is coated with an enamel or other coating.
>
> "It is an object of this invention to provide a novel brake for bending and forming sheet metal which obviates the foregoing disadvantages of prior art brakes.

"It is a further object of the invention to provide such a brake which is light in weight, simple to operate and low in cost."

Claim 7 of the patent, which is relied on by Tapco, provides:

"7. In a brake tor bending sheet metal, the combination comprising

a first member having a flat clamping surface,

an anvil member for clamping a piece of metal against said flat clamping surface on said first member,

a second member having a flat bending surface,

each of said first and second members having substantially the entire length of the longitudinal edges thereof formed with longitudinally spaced intermeshing integral projections,

each said projection of each said member having a surface thereof lying in the plane of the flat surface of its corresponding member,

said projections having aligned openings therein,

and a hinge pin extending through said integral projections and thereby defining a hinge so that said second member may be swung relative to said first member to bend said metal about said anvil member."

Prior to issuance of the patent Tapco had been a distributor for a brake embodying the features of the Rauen prior art patent number 3,147,791, manufactured by Lyf-Alum, Inc., of which the patent in suit is an improvement

principally in the hinge arrangement which connects the clamping member with the bending member. The Rauen hinge was separately attached to the clamping and bending members by bolts or screws.

In the Marsh patent the hinge was formed by intermeshing integral projections extending the entire longitude of the edges of the clamping and bending members. Each projection has a flat surface in the plane of the flat clamping and bending surfaces. A pin extends through the projectons in order that the bending member may be swung about the clamping member and may bend the metal on the anvil. The hinge on Rauen has a round rather than a flat surface.

Dr. Youngdahl, plaintiff's expert witness, testified that the Marsh patent produces a straighter, sharper, and more uniform bend than does the Rauen patent, and does not mar the surface of the metal. He attributed this to the fact that the Marsh hinge more closely confines and supports the metal as the bending member reaches a vertical position. It was his opinion, demonstrated by a test which he made, that the Rauen hinge leaves a longitudinal groove, or a gap, between the clamping and bending members which results in less support or confinement of the metal during the final portion of the bend. He further testified with respect to the Rauen brake:

> "Now on that we are going to put our piece of sheet metal and we will clamp that piece of sheet metal—I'll use white chalk for that—with our clamping member, an anvil. To cause our bend we are going to pivot about this point. I think you can see, your Honor, that all I have done is just looked right at the end. We are only looking at this end view. We have to realize that

this piano hinge goes a long way down here and these surfaces go down. We are going to pivot member 17 about 16 at this point and cause our sheet metal to bend.

"Now, when that bending occurs this area at the hinge and the space, the metal is unsupported, there is nothing there to support it. If we move the hinge up where it contacts the metal, it puts a mark on it. This metal in this stock that we are bending has a thin coat of paint on it, oven white. They are going to put it on a man's house and if he sees these marks on it he won't pay for the job, is what it amounts to.

"So if the hinge is set high it marks it, the piano hinge; and if it's set low, it's unsupported. Then when you cause your pivot, your part 17 to pivot about the hinge and come up, you apply the force out where you have contact. The place where you have no contact has no force applied, is unsupported and tends to bulge. In fact, when you get your bend completed you end up with a bend that is not square and is not uniform but rather comes down and has a bulge in it, and that bulge varies along the length of the piece so as you sight down the piece, one place it might be square, another place the bend might have a bulge in it more or less and it isn't uniform. It's a random thing. When you don't support it and don't control it you have a random bulging that can occur along the full length because you realize I have only drawn one section and this is 8 or 10 feet long.

"THE COURT: That's the Rauen patent you are talking about?

A. That's the Rauen patent I am talking about."

With respect to the Marsh hinge, Dr. Youngdahl concludes:

> "Our sheet metal before bending is lying flat. It's in contact there. As we bend up we have surface contact and our metal is under control all the time. We know what's going to happen to it and we get a better bend. You can see right here where each of these projections have a surface and if we put a ruler on there it's supported in the area of the hinge. In a brake of considerable length, say, an 8′ foot brake, that amounts to a lot of area. This is much enlarged in scale but it wouldn't be at all unreasonable for that dimension that is unsupported there to be 3/16th of an inch, in fact, I think it's quite conservative. 3/16th is very little in a piano hinge, to fit a piano hinge in. If I were to take that 3/16th of an inch and multiply it by 8′, it would be 3/16ths x 8′, x 12″ per foot, and I get 18 square inches that I now support rather than have unsupported; and it's this additional support that, in my opinion, is the biggest factor in making a better bend on the patented brake than on a brake with a piano hinge."

In comparing the final stages of bending, as the bend approaches the vertical, using the Rauen hinge to the result achieved with the Marsh hinge, Dr. Youngdahl testifies:

> "I didn't intend to show that that all occurred right at this position. Where that flow of metal occurred is on the way up. You can see it. There is no support in there on the way up so you have no way of applying pressure on that up at the top and take that kink out. You can see it on the parts and you can see it on the brake."

The District Judge, during cross-examination of Dr. Youngdahl, became cognizant of the invention when he stated:

> "THE COURT: I think I've got his point. His point is that the projections, like take the top of a rubber ball and you cut off the top and it's straight across and that's what I think he is trying to say. Here the hinge leaves a little space between the rounded portion as it goes into the remaining top of the instrument but in their claim, the Marsh patent, I think he is trying to say that the hinge has been flattened off on top so that it's solid across; am I correct?
>
> A. That's right, that's exactly what it says.
>
> THE COURT: That's what you think is, in your opinion, a substantial difference sufficiently which would merit a patent and I think that is why you added your Claim 7 in your wording, is that right?
>
> A. That's right.
>
> Q. (By Mr. Cantor, continuing): That's what you consider to be the invention here?
>
> THE COURT: Yes, that's right.
>
> A. Yes, simply."

Defendants' only expert witness, Frank, whose deposition was read into evidence, testified only about the Noyes patent. There is no testimony in the record to refute Dr. Youngdahl's theories.

Appellees contend that the use of an integral hinge is old. The Patent Examiner recognized this, but allowed claim 7 for a different reason, stating:

> "1. Figure 3 of the drawings has been corrected.
>
> "2. Claim 7 is allowed.

"3. Claims 1-6 are rejected as not patentable over applicant's admittedly prior art bending brake which was demonstrated to the Examiner. The instant brake differs from the prior art brake in the use of an integral hinge as opposed to an attached or separate hinge. It is well recognized in the arts that it is obvious to make two or more separate parts integral. At the recent demonstration of applicants' brake it was impressed upon the Examiner that the new and unobvious results were obtained not solely by the use of an integral hinge but from the use of an integral hinge positioned such that it's component projections did not extend above the plane of the surface of their corresponding members. Upon inclusion of such a limitation in claims 1-6 they will be allowed.

"4. Claims 1-6 are rejected."

The positioning was caused by the flat surfaces of the Marsh hinge in the plane of their corresponding members, rather than the round surfaces of the Rauen hinge which were not in a plane with their corresponding members.

The Marsh brake met with immediate commercial success. With no established sales force, and using mailings of circulars, advertisements in trade journals, and displays at trade shows, plaintiff's total sales were about $127,000 in 1963, and $236,000 in 1964. The total combined sales of plaintiff and Van Mark of metal brakes of the Marsh patent were $356,000 in 1965, $427,000 in 1966, $519,000 in 1967, and $692,000 in 1968.

During the period of these sales the Marsh brake was sold in competition with the prior art Rauen brake. The

only substantial difference between the two brakes was the hinge. Furthermore, plaintiff sold its brake for a price which was around 38% more than the price charged for the Rauen brake.

As to the commercial success enjoyed by plaintiff, the District Court made the following observations:

> "As to the existence of the commercial success enjoyed by Tapco, the court makes two observations. To the extent that plaintiff improved on the existing bending brakes available in their market, they showed they had a useful improvement although it was unpatentable. And, inasmuch as plaintiff produced its sheet metal brake under color of patent they were bound to meet with success, due to the absence of competition."

It should not be overlooked that Van Mark was selling the patented brake in competition with plaintiff, the owner of the patent.

While commercial success will not validate a patent where invention is lacking, nevertheless in a close case where there is doubt about invention, it must be considered and may well be sufficient to tip the scales in favor of validity. *Goodyear Tire & Rubber Co. v. Ray-O-Vac Co.*, 321 U.S. 275 (1944); *General Elec. Co. v. Sciaky Bros. Inc.*, 304 F. 2d 724 (6th Cir. 1962); *Aluminum Co. of America v. Sperry Prods.*, 285 F. 2d 911 (6th Cir. 1960), *cert. denied*, 368 U.S. 890 (1961).

Here the invention is narrow. It is aided by the statutory presumption in favor of validity. 35 U.S.C. § 282.

Defendants could easily have avoided liability by choosing any one of the many alternatives to copying the Marsh brake. Among these alternatives, defendants could have continued to use the prior art Rauen brake; they could

have welded a Rauen-type hinge onto the members for greater hinge stability; or they could have used an extruded integral hinge of any design which did not adopt plaintiff's teaching to position the surface of the hinge projections flush with the plane of their corresponding member surfaces.

Furthermore, after litigation defendants made a settlement with plaintiff by taking a non-exclusive license involving substantial royalty payments. Surely they had ample time prior to making the settlement to investigate the Marsh patent and the prior art and to determine whether the improvement was obvious, whether it had utility, and whether it was achieving substantial commercial success.

Speaking of the presumption of validity, Circuit Judge Phillips, who is now Chief Judge, in *Monroe Auto Equip. Co. v. Heckethorn Mfg. & Supply Co.*, 332 F. 2d 406, 412-13 (6th Cir. 1964), said:

> " . . . [W]e also recognize that a presumption of validity attaches to a patent once it has been issued by the patent office. 35 U.S.C. § 282; Aluminum Co. of America v. Sperry Products, Inc., 285 F. 2d 911, 916 C.A. 6), cert. denied, 368 U.S. 890. This is only proper because of the complexities of patent law and the expertise of the patent office. See Williams Mfg. Co. v. United Shoe Mach. Corp., 121 F. 2d 273, 277 (C.A. 6), cert. denied, 316 U.S. 364, 62 S. Ct. 1179, 86 L.Ed. 1537. However, the large number of patents declared invalid by the courts bear telling witness to the fact that this presumption is in no way conclusive. The presumption of course is weakened if applicable prior art has not been considered by the patent office. Harvey v. Levine, 332 F.2d 481, 484 (C.A. 6); Aluminum Co. of America v. Sperry Products, Inc., supra."

On the other hand, where the most pertinent prior art has been considered by the patent office, the presumption is greatly strengthened. *Great Lakes Equip. Co. v. Fluid Sys., Inc.*, 217 F.2d 613, 617 (6th Cir. 1954), citing *Williams Mfg. Co. v. United Shoe Mach. Corp.*, 121 F. 2d 273, 277 (6th Cir. 1941), aff'd, 316 U.S. 364 (1942).

In the present case the defendants contend that the most pertinent prior art was not submitted to nor considered by the Patent Examiner. Certainly the Rauen letters patent were not submitted. On the other hand plaintiff did submit to the patent office and demonstrated a brake of its own manufacture, which brake in all respects important to this case embodied the disclosures of the Rauen patent.

Furthermore, so far as the prior art was cited by defendant to establish the obviousness of an integral hinge, the question of whether the Noyes (992,038 [1911]), Moynahan (2,288,013 [1942] airplane wing), or Rauen patents were considered seems irrelevant since the Patent Examiner considered an integral hinge obvious to those skilled in the prior art, and disallowed claims 1-6 as originally written. In fact, the Examiner allowed claim 7 only because it described the top surface of the hinge as being flat and lying within the plane of the corresponding members' surfaces. In our opinion, the normal presumption of validity attaches, and may be "greatly strengthened" by consideration of the state of the prior art, even though the particular letters patents upon which defendants rely to establish that art, were not considered.

It should also be noted that Judge Phillips, in *Monroe*, cautioned against the use of prior patents from a "non-analogous" art. It is submitted from the above conclusion that even the Patent Examiner considered integral piano hinges obvious, and that the question of invention (which

is synonymous with unobviousness) centers around whether the flat hinge top, lying in the plane of the surfaces of the corresponding members, is obvious.

On this particular question, the only pertinent prior art cited by defendant which the Patent Examiner could have considered, is the old Noyes patent which was on a blacksmith's jig for making beam-clamps. However, a substantial problem arises as to whether this is non-analogous prior art. While the Noyes patent is used for some metal bending, the metal bent is relatively narrow, thick metal bars or beams, which are heated. In fact, it appears that most of the bending is done by a hammer. While the bending lever of the jig has flat fingers which could be called projections, the clamping members, unlike Marsh, have no projections, and the clamping surfaces do not lie on the same plane as the flat surfaces of the spaced fingers to which the bending handle is pivoted. The bar or anvil does not clamp the heated metal against any clamping surface. On p. 2, col. 1 of the Noyes patent, it is stated that bending lever 24 apparently does do some bending in the final step of the formation of the clamp; however, a squared corner is not desired and it does not appear that the hinge has any supporting function during the bend.

THE TEST OF OBVIOUSNESS AND "ANALOGOUS PRIOR ART"

Obviousness is said to mean that the particular, claimed improvement would be obvious to one skilled in and knowledgeable of the "prior art." In determining obviousness or non-obviousness, the courts must make factual inquiry into the scope and content of prior art, the differences between prior art and the claims at issue, and the level of or-

dinary skill in the pertinent art. See generally, *Graham v. John Deere Co.*, 383 U.S. 1 (1966).

Putting aside the question of whether utility could be challenged, it seems fairly clear that if there is no functional improvement made by the flat-topped hinge, then the mere use of an integral piano-type hinge would be obvious and it was so considered by the Patent Examiner. If, however, the flat-topped hinge is a functioning improvement to the prior art, then it would be patentable (so far as obviousness is concerned) unless it could be proved by defendants, with clear proof, that the prior art would suggest to a person skilled in the art the particular combination and configuration of ideas adopted by plaintiff.

The Supreme Court's treatment of the various patents-in-suit in *Graham v. John Deere Co., supra,* discloses that in discussing "obviousness" and finding the patents invalid, the Court assumed the usefulness of the claims, but found that the particular configuration chosen, even if not disclosed in any single prior patent, merely achieved a result in adoption of a principle known to the art, but achieved by a slightly different arrangement which would be obvious to anyone skilled in the art.

On the question of what constitutes "analogous" prior art, it is evident that the Supreme Court in *Graham* felt a broad reading of the term was required. *See, e.g.*, 383 U.S. at 19, 35. Thus, in the present case, the choice of "machine designing" generally (although a broad category) as the pertinent prior art, seems appropriate.

Accepting the Noyes and Moynahan patents as applicable prior art, we cannot see where the particular combination of parts to achieve a better result on a sheet metal bending brake is pointed out by the prior art. Granted,

an integral hinge is not new; but under the assumption that the flat-topped "gapless" hinge contributes to achieve the result, there is only the 1911-Noyes patent cited by defendants to show "obviousness." Yet as we have previously pointed out, Noyes does not disclose the "obviousness" of the use of a flat-topped hinge to give support to the metal as it is being bent, or to make a better bend.

Plaintiff has combined the old art piano-type integral hinge with a new type "flat, gapless" hinge not known to the prior relevant art, in such a way as to create a new, better and unsuspected result. The Marsh hinge provides greater support and prevents the sheet metal from slipping into a "gap," and thus prevents non-uniformity and marring.

The invention certainly is not dramatic, but it does not have to be so. As well stated by District Judge Jones in *Squeez-a-Purse Corp. v. Stiller,* 175 F. Supp 667, 669, (N.D. Ohio 1959), *aff'd* 280 F. 2d 424 (6th Cir.), *cert. denied,* 364 U.S. 828 (1960):

> "It is realized and must be conceded that the defendants' article is not of striking inventive quality; it is in fact one of modest proportions, but ' 'tis enough, 'twill serve' as an article made up of a unique and unitary combination of old elements with new and useful elements (F and G) which constitutes a definite advance which has received universally wide acceptance and instant commercial success in its field and has contributed more than a little to its art. To this, plaintiff has added its tribute by producing and marketing an indistinguishable copy."

In *Goodyear Tire & Rubber Co. v. Ray-O-Vac Co.,* 321 U.S. 275, 279 (1944), the Court stated:

> "Viewed after the event, the means Anthony adopted seem simple and such as should have been obvious to those who worked in the field, but this is not enough to negative invention . . . [footnote omitted]."

UTILITY

Of course, if as the defendants contend, the flat, gapless features have no utility, then the "invention" would only be the use of an old integral piano-type hinge which everyone agrees was obvious.

Defendants have continuously argued that the flat surface of the hinge parts, lying flush in the planes of their corresponding clamping and bending members, serves absolutely no functional purpose at any time during the bend. Further the defendants have asserted that the old, separate piano hinge (where, due to a rounded hinge, a "gap" existed between the flat surfaces of each member and the point where the top of the hinge met the plane of the member surface) did not permit a slipping of the metal into the "gap" causing an uneven bend and marking of the coated surface. To establish this, defendants particularly relied upon the demonstrations made by defense counsel to the Court on bending brakes of Rauen, and of plaintiff's patented brake.

As suggested above, this would appear to challenge the usefulness of precisely that claim upon which plaintiff's patent rests; briefly, defendants challenge the utility of the patented brake. There is a substantial doubt that the defendants may be permitted to do so.

A rule of long standing in this Circuit and still adhered to is that "one who appropriates the teachings of a patent

may not deny the utility of the invention." *U.S. Gypsum Co. v. Consolidated Expanded Metal Cos.*, 130 F. 2d 888, 889 (6th Cir. 1942), *cert. denied*, 317 U.S. 698 (1943). See also, *Miller v. Daybrook-Ottawa Corp.*, 291 F. Supp. 896 (N.D. Ohio, 1968).

There can be little question that defendants have copied, virtually exactly, plaintiff's bending brake. There is no question that defendants have used a piano-type integral hinge with the flat surfaces claimed by plaintiff. Thus, according to the established rule in this Circuit, it would seem that defendants may not challenge the utility of the flat surfaces which plaintiff claims as its invention.

It should be noted that defendants' proof as to lack of utility is questionable to say the least. They claim that the demonstrations made by defense counsel discredited the explanation of Dr. Youngdahl, plaintiff's expert. However, the thrust of Youngdahl's testimony was that great additional support was given by the hinge during the bending, particularly in its final stage, without permitting the metal to slip down in a "gap" left by the hinge. Since Dr. Youngdahl's testimony was directed to the "critical" final stage as the bend approached the vertical, the demonstration by defense counsel, which embodied only partial bends, logically cannot credit nor discredit Dr. Youngdahl's testimony. Further, it is noted that one of the problems solved by plaintiff's brake was the lack of uniformity in bend along the length of the sheet metal. This difficulty was experienced particularly with respect to sheet metal bent along lengths up to several feet, whereas the bending demonstrated in court was on sheet metal no longer than one inch along the bend. It might very well be that a bend that was only one inch in length could be achieved with uniformity and without slipping, whereas a bend of a ten-foot section of sheet metal could involve entirely different pres-

sures and forces upon it, causing lack of uniformity over its length, either through "slipping" into the "gap" or through lack of the support asserted to be afforded by the flat-topped hinge.

Although the District Court found Dr. Youngdahl's theories "plausible," he rejected them relying "most heavily" on the courtroom demonstration of a partial bend made by defendants' counsel, who was not sworn as a witness and did not qualify as an expert. As we have pointed out, the validity of this demonstration was questioned at the time. Furthermore, when plaintiff's witness, Dr. Youngdahl, who qualified as an expert, endeavored to make a demonstration in open court, the following episode took place:

> "Dr. Youngdahl:
>
> Plaintiff's Exhibit 16 is a piece of painted aluminum metal that is used on the brake, Plaintiff's Exhibit 18, to bend up the 1" flange I might demonstrate on the brake.
>
> "The Court:
>
> Don't demonstrate. I don't want to see it unless somebody wants it particularly."

No one stated that he wanted to see the test and it was not made by Dr. Youngdahl. After Dr. Youngdahl had completed his testimony and left to return to California, counsel for defendants undertook to make the questionable demonstration.

Defendants had full opportunity to offer evidence to refute the testimony of Dr. Youngdahl, but they did not do so.

It would seem to us that the demonstration by opposing counsel more properly should have been made as part of

the cross-examination of Dr. Youngdahl, or at least it could have been supported by sworn testimony of witnesses with the right of plaintiff to cross-examine. The unsworn, self-serving statements of counsel are not evidence.

In our opinion, claim 7 particularly points out and distinctly claims the subject matter of the invention.

The statute provides:

> "Patentability shall not be negatived by the manner in which the invention is made." 35 U.S.C. § 103.

Nor do the statutes require that an inventor understand and disclose the theory of his invention. He is entitled to all of the benefits of his invention, even though they were greater than he believed. Dellers Walker on Patents, 2d Ed., Vol. 4, § 238, pp. 106, 107.

Infringement was not made an issue in the District Court nor here.

In our opinion, Claim 7 of the Marsh patent is valid and was infringed by the defendants. The judgment of the District Court is reversed and the cause is remanded for further proceedings consistent with this opinion.

No. 20,835

UNITED STATES COURT OF APPEALS

for the Sixth Circuit

Tapco Products Company,
Plaintiff-Appellant,
vs.
Van Mark Products Corporation
and
Eugene Van Cleave,
Defendants-Appellees.

ORDER ON PETITION FOR CORRECTION AND REHEARING

(Filed August 30, 1971)

Before Weick, Peck and McCree, Circuit Judges.

Appellees have attached to their petition for correction and rehearing a so-called petition appendix containing thirty photographs of physical exhibits in the office of the United States Marshal in Detroit, taken on July 16, 1971, after our decision in this case had been announced on July 12, 1971. Enlargements of some of these photographs appear in the petition for correction and rehearing. The photographs purport to show an *ex parte* demonstration conducted by appellees in the absence of appellant's counsel, demonstrating the bending of sheet metal in various stages by the patented machine and the prior art sheet metal bending brake.

In addition, appellee shipped to the Court the large physical exhibits 18, 19 and 4, and asked the Court "to try out

these exhibits and observe their bending operations", and furnished operating instructions. In the letter of transmittal to the Court appellees admitted that this approach was "unorthodox." It certainly is. Counsel states:

> "We believe there is precedent for this. We understand that in the oral argument in U.S. v. Adams, 1966, 383 U.S. 39, the Supreme Court permitted counsel to demonstrate the patented device."

There is nothing in the opinion of the Supreme Court to substantiate this assertion, but even if true, the Court certainly did not permit an *ex parte* experiment or demonstration after the case had been argued and decided.

Appellees made no request to us for permission to conduct a demonstration of the physical exhibits 18, 19 and 4 prior to our decision of the case. The approach here is unprecedented. The photographs in the petition appendix and the enlargements in the petition which depict the demonstration are not in evidence in the case and cannot be considered by us.

In our Opinion we discussed the demonstration conducted by appellees' counsel in the District Court after plaintiff's expert, Dr. Youngdahl, had finished his testimony and left for California. We stated:

> "Defendants had full opporutnity to offer evidence to refute the testimony of Dr. Youngdahl, but they did not do so.
>
> "It would seem to us that the demonstration by opposing counsel more properly should have been made as part of the cross-examination of Dr. Youngdahl, or at least it could have been supported by sworn testimony of witnesses with the right of plain-

> tiff to cross-examine. The unsworn, self-serving statements of counsel are not evidence."

We would also point out the fact that, as appellees apparently recognize, the burden of proving invalidity rested upon them. Their argument has always been that the courtroom demonstration by appellees' counsel discredited Dr. Youngdahl's testimony and sustained their burden. We fully answered that contention in our Opinion, which stated:

> "Since Dr. Youngdahl's testimony was directed to the 'critical' final stage as the bend approached the vertical, the demonstration by defense counsel which embodied only partial bends, logically cannot credit nor discredit Dr. Youngdahl's testimony."

This same passage also points out that the enlargements in the petition for rehearing do not conform to the demonstrative evidence of defense counsels' demonstration at trial, since the enlargements depict the "critical" final stage as the bend approaches the vertical. In short, it is too late for appellees to supply deficiencies in their proof.

Appellees also argue in their petition for rehearing that they do not challenge the utility of the claimed invention. In our Opinion we noted that the appellees argued that the claim of invention, which relates only to the "flat, gapless" feature of the hinge, served no functional purpose, and we held that to challenge the validity of the patent on this ground was to challenge utility, which appellees are barred from doing. Appellees merely reaffirm their challenge of function in their petition for rehearing.

> "What is challenged is the false, non-existent *function,* namely, that the hinge also *functions* to support

> the sheet metal during bending." (Appellees' Petition for Rehearing at 6-7 [emphasis added]).

The appellees' remaining contentions are so frivolous and insubstantial as to require no further discussion.

The petition to correct and rehear is denied.

Entered by order of the Court.

/s/ James A. Higgins
Clerk.

District Court, E. D. Michigan, S. Division

Tapco Products Company, Inc.
v.
Van Mark Products Corporation, et al.

No. 31627 Decided July 28, 1970

OPINION

PATENTS

1. Patentability — Evidence of — Commercial success — Causes (§51.4555)

In considering commercial success, court notes that, inasmuch as patent owner produced device under color of patent, it was bound to meet with success, due to absence of competition.

Particular patents—Sheet Metal Brake

3,161,223, Marsh, Sheet Metal Brake, invalid.

Action by Tapco Products Company, Inc., against Van Mark Products Corporation and Eugene Van Cleave for patent infringement, unfair competition, and breach of patent license. Patent held to be invalid.

Basil C. Foussianes, Barnes, Kisselle, Raisch & Choate, Walter O. Koch, and Bodman, Longley, Bogle, Armstrong & Dahling, all of Detroit, Michigan, for plaintiff.

Bernard J. Cantor, Hiram P. Settle, Jr., Daniel G .Cullen, and Cullen, Settle, Sloman & Cantor, all of Detroit, Michigan, for defendants.

Kaess, District Judge.

This is a case involving validity and infringement of the Marsh Patent No. 3,161,223 relating to a sheet metal bending brake.

The plaintiff, Tapco Products Company, Inc., is a manufacturer of sheet metal bending brakes and is the owner of the Marsh Patent No. 3,161,223. The defendant Eugene Van Cleave was a former employee of the plaintiff; and after leaving the plaintiff's employ, Van Cleave formed Van Mark Products Corporation, which entered into the production of sheet metal bending brakes, in competition with the plaintiff.

Plaintiff sued the defendants for unfair competition and the appropriation of trade secrets in the Michigan Circuit Court in Wayne County. That suit was settled, and as a part of the settlement, license royalties were to be paid by the defendant Van Mark Products Corporation to the plaintiff Tapco. Defendants failed to comply with their royalty obligations and after some renegotiations all cooperation between the parties broke down.

Plaintiff thereupon filed the present suit, alleging patent infringement, unfair competition, and causes of action arising out of the license agreement.

The parties and the court have agreed to a postponement of trial on the remaining issues until the issue of patent infringement and validity has been determined. Therefore this opinion is restricted in scope to the issue of the patent itself.

The inventiveness relied upon by the plaintiff in support of the Marsh Patent No. 3,161,223, in claims 1-6, is as follows:

> "each of said first and second members having substantially the entire length of the longitudinal edges

thereof formed with longitudinally spaced intermeshing integral projections,

each said projection of each said member being positioned such that all portions thereof do not extend above the plane of the surface of its corresponding member when the surfaces are substantially aligned,

said projections having aligned openings therein,

a hinge pin extending through said integral projections and thereby defining a hinge so that said second member may be swung relative to the first member for bending sheet metal about said anvil member."

And the inventiveness relied upon in claim 7 is as follows:

"each of said first and second members having substantially the entire length of the longitudinal edges thereof formed with longitudinally spaced intermeshing integral projections,

each said projection of each said member having a surface thereof lying in the plane of the flat surface of its corresponding member,

said projections having aligned openings therein,

and a hinge pin extending through said integral projections and thereby defining a hinge so that said second member may be swung relative to said first member to bend said metal about said anvil member."

The record discloses that plaintiff's claim of invention is based upon two improvements—(1) the use of an "integral" hinge to strengthen the bending mechanism, (2) the use of flat hinge projections not to extend above the

bending surfaces in order to give additional support for a more uniform bend.

The defenses raised in opposition to the plaintiff's allegation of patent validity are (1) obviousness under 35 U. S.C. § 102, and (2) failure to claim the alleged invention in accordance with 35 U. S. C. § 112.

On the question of obviousness, the Supreme Court laid down requirements for such a determination in the case of Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459, 466-467 (1966), wherein Justice Clark delivering the opinion of the court states:

> "Approached in this light, the § 103 additional condition, when followed realistically, will permit a more practical test of patentability. The emphasis on nonobviousness is one of inquiry, not quality, and, as such, comports with the constitutional strictures.
>
> While the ultimate question of patent validity is one of law, A. & P. Tea Co. v. Supermarket Corp. (340 U.S. 147 [1950]) at 155, 87 USPQ 303, 307, the § 103 condition, which is but one of three conditions, each of which must be satisfied, lends itself to several basic factual inquiries. Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. As indicia of obviousness or nonobviousness, these inquiries may have rele-

vancy. See Note, Subtests of 'Non-obviousness'; A Nontechnical Approach to Patent Validity, 112 U. Pa. L. Rev. 1169 (1964).

This is not to say, however, that there will not be difficulties in applying the nonobviousness test. What is obvious is not a question upon which there is likely to be uniformity of thought in every given factual context. The difficulties, however, are comparable to those encountered daily by the courts in such frames of reference as negligence and scienter, and should be amenable to a case-by-case development. We believe that strict observance of the requirements laid down here will result in that uniformity and definiteness which Congress called for in the 1952 Act.

While we have focused attention on the appropriate standard to be applied by the courts, it must be remembered that the primary responsibility for sifting out unpatentable material lies in the Patent Office. To await litigation is—for all practical purposes—to debilitate the patent system. We have observed a notorious difference between the standard applied by the Patent Office and by the courts. While many reasons can be adduced to explain the discrepancy, one may well be the free rein often exercised by examiners in their use of the concept of 'invention'."

In the light of the Supreme Court's ruling in Graham, this court finds the record in the case at bar to be adequate for determining the question of obviousness.

The prior art as manifested by the Moynihan Patent No. 2,288,013 and the Noyes Patent No. 992,038 indicates that integral hinges were known prior to the patent-in-suit and had previously been used in bending devices. The testi-

mony of both experts, Mr. Youngdahl and Mr. Frank, unquestionably indicates to the court that integral hinges were recognized by those skilled in the art as being a stronger hinge and had been put to use previously in bending brakes. Further, the Patent Office Examiner's opinion, contained in the Marsh Patent file wrapper, indicates that the use of the integral hinge is obvious, for as he stated with reference to the integral hinge:

> "• • • It is well recognized in the arts that it is obvious to make two or more separate parts integral • • •" (Tr. 137)

Thus, this court finds the plaintiff's first alleged improvement, the employment of an integral hinge in the Marsh Patent No. 3,161,223, to be obvious to one skilled in the art at the time of the invention.

The Patent Office Examiner's opinion, however, turned on a different point as indicated by the following statement:

> "• • • At the recent demonstration of the applicant's brake it was impressed upon the examiner that the new an[d] unobvious results were obtained not solely by the use of an integral hinge but from the use of an integral hinge positioned such that its component projections did not extend above the plane of the surface of their corresponding members."

This brings us to plaintiff's second alleged inventiveness—the use of flat hinge projections not to extend above the bending surfaces in order to give additional support for a more uniform bend.

The defendants reject this alleged inventiveness on two bases: (1) it was not properly claimed in accordance with

35 U.S.C. § 112, which requires the patentee to specify his invention in the claims, Kaiser v. McLouth, 400 F.2d 36, 158 USPQ 565 (6th Cir. 1968); and (2) it is not the proper subject for patent because it is not true.

As to the claims made in the Marsh Patent, there are two descriptions of the configuration or location of the hinge projections.

In Claims Nos. 1, 4, 5 and 6 it is stated that:

> "* * * each said projection of each said member being positioned such that all portions do not extend above the plane of the surface of its corresponding member when the surfaces are substantially aligned,"

And in Claim No. 7 it is stated that:

> "* * * each said projection of each said member having a surface face thereof lying in the plane of the flat surface of its corrsponding member."

The defendants maintain that in Claims Nos. 1, 4, 5, and 6 the words "do not extend above the plane of the surface of its corresponding member" admit to the possibility of extending below such a plane which has been shown to be the case in prior art. Defendants further maintain that in Claim No. 7 the words "having *a* surface face" admit to the possibility that not *all* of the surface of the projections need lie in that same plane. This also has been shown to be the case in prior art.

Therefore, the defendant concludes that the "gapless" hinge projections theory espoused by Mr. Youngdahl's testimony is not included in the patent claims. For had they been so included, the claims would have required *all* of the surface face of the hinge projections to lie in the plane of the corresponding members.

The court sees merit in the defense proposed interpretation of the patent claims. Thus, the court questions whether the gapless hinge projection theory is covered by the claims as written. But the plaintiff's interpretation is also deserving of merit.

However the court, not wishing to become engulfed in a battle of semantics, relies most heavily upon the court room demonstration, which negates plaintiff's position. The court personally observed actual physical samples of both a prior art brake and a Marsh patent brake. In both instances, the sheet metal was lifted away from the hinge as the metal was bent, due to the geometric characteristics of the spacing of the brake parts in relation to the metal to be bent.

Thus, the court finds plaintiff's interpretation of flat, gapless hinge projections providing additional support and producing a more uniform bend to be unsupported in fact and therefore the court finds defendants' interpretation of the claims to be the proper one.

As a result plaintiff's second allegation of inventiveness must also fall.

[1] As to the existence of the commercial success enjoyed by Tapco, the court makes two observations. To the extent that plaintiff improved on the existing bending brakes available in their market, they showed they had a useful improvement although it was unpatentable. And, inasmuch as plaintiff produced its sheet metal brake under color of patent they were bound to meet with success, due to the absence of competition.

Therefore, the court finds the plaintiff's patent to be invalid and orders the entry upon the record in this matter No Cause of Action for Patent Infringement.

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Supreme Court of the United States

OCTOBER TERM, 1971

Docket No. 71-449

VAN MARK PRODUCTS CORPORATION and
EUGENE VAN CLEAVE,
Petitioners,
vs.
TAPCO PRODUCTS COMPANY,
Respondent.

BRIEF FOR RESPONDENT IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SIXTH CIRCUIT

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IN THE

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TAPCO PRODUCTS COMPANY,
Respondent.

BRIEF FOR RESPONDENT IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SIXTH CIRCUIT

Respondent respectfully prays that the Petition for Writ of Ceritorari to review the judgment of the United States Court of Appeals for the Sixth Circuit Court in its cause No. 20,835 be denied.

I. GROUNDS FOR THIS COURT'S JURISDICTION

Contrary to Petitioners' assertion, jurisdiction cannot be conferred on this Court by United States Code, Title 28, Section 1251 (1) because this cause does not involve "controversies between two or more States" and does not involve the original jurisdiction of this Court. Perhaps Petitioners intended to assert jurisdiction under Title 28, Section 1254 (1) providing for review by Writ of Certiorari.

II. STATEMENT OF THE CASE

In view of the numerous inaccuracies, omissions, and unsupported contentions in the Petitioners' Statement of the Case, Respondent has restated the case and commented on such inaccuracies, omissions and unsupported contentions.

This is an ordinary suit for infringement of the Marsh Patent No. 3,161,223 brought by Respondent against its former employee, Petitioner Van Cleave, and former licensee, Petitioner Van Mark Products Corporation, which was organized by Van Cleave to produce infringing sheet metal bending brakes in competition with Respondent. This license resulted from settlement of a Wayne County Michigan Circuit Court suit against Petitioners for unfair competition and appropriation of trade secrets and provided for a royalty rate of 5½% and a $10,000 royalty prepayment. Due to Petitioners' failure to make such royalty payments, Respondent terminated the license and brought this action for patent infringement and other causes. No other Courts have considered the Marsh patent

and hence, there are no conflicting decisions with the Court of Appeals Opinion reversing the District Court and holding the Marsh patent valid and infringed.

A. The Marsh Patent in Suit and the Prior Art Rauen Patent

A sheet metal bending brake is a device with a clamping member (referred to by Petitioners as a "table"), an anvil for clamping sheet metal against the clamping member, and a bending member (referred to by Petitioners as a "bending leaf" or "leaf") hinged to the clamping member so that it can swung relative to the clamping member to bend the sheet metal about the anvil (R. 60-61). In the Marsh patent the hinge structure consists of intermeshed projections integral with and extending the entire length of the bending and clamping members with each projection having a flat top surface thereon lying in the plane of the flat surface of its associated bending or clamping member (R. 34-40, 257-258 and A. 4a). Claim 7 of the Marsh patent which defines this flat top hinge structure was found valid and infringed by the Court of Appeals and is set forth at page 10 of the Petition and A. 3a. This hinge construction with its specific configuration of projections is referred to by Petitioners as a "flat top hinge".

The brake of the Marsh patent (hereinafter "Marsh brake") is typically used on the job site by contractors for making right angle bends in painted coil stock for forming aluminum siding and particularly aluminum trim parts placed around windows, doors, and eaves of a house (R. 33). The Marsh brake produces a right angle bend in the sheet metal which is sharper, straighter, and more uniform without marring the painted sheet metal than the

bend produced by the Rauen type brake (R. 254-258). This is of great practical significance to contractors because homeowners are very critical and refuse to pay contractors who put marred and crooked aluminum trim pieces on their homes (R. 268).

The principal prior art reference is Rauen Patent No. 3,147,791 which was filed before the application for the Marsh Patent was filed. Prior to development of the brake of the Marsh patent, Lyf-Alum, Inc., manufactured the bending brake of the prior art Rauen patent which Respondent initially sold as a distributor and then as a manufacturer (R. 93-4, 111-12, 116-17 and A. 3a-8a). The Rauen type brake has a clamping member pivotally connected to the bending member by a separate piano hinge (referred to by Petitioners as a "round top hinge") bolted to the longitudinal edges of the members (A. 4a). This Rauen type brake was described as prior art in the Marsh patent as "a brake for bending and forming sheet metal such as aluminum coil stock may comprise a pair of members which are hinged to one another by a hinge such as a piano hinge having the leaves thereof fixed to the respective members" (Marsh patent, Col. 1, L. 9-13). The Marsh patent also indicates that making the round top piano hinge Rauen type brake in substantial length "not only results in an improper bend but, in addition, mars the surface of the sheet metal where it is coated with an enamel or other coating" (Marsh patent, Col. 1, L. 19-21). A sample of the brake of the Marsh patent was demonstrated to the Patent Office Examiner in charge of the Marsh patent application and was distinguished as prior art before claim 7 was allowed (R. 133-139).

B. The Unexpected Results Produced by the Hinge Structure of the Marsh Patent

Contrary to the assertion at page 7 of the Petition, neither the flat top hinge structure nor the unexpected results of an improved bend without marring produced thereby were old or known in the prior art. There is no support in the record for such a conclusion, the District Court made no such finding, and the Court of Appeals expressly found to the contrary (A. 12a, 13a-14a). Similarly, the contention at page 7 of the Petition that both lower courts "found that the mere substitution of an old integral hinge for the separate hinge was dictated by the prior art and was obvious" is inaccurate, overly broad and potentially misleading. The lower courts merely found that the substitution of an *integral* for a *separate* round top piano hinge (as used in the Rauen patent) would be obvious. However, the District Court did not specifically find that the use of the flat top hinge structure was dictated by the prior art or obvious and the Court of Appeals expressly found to the contrary (A. 13a-14a).

The Petition in discussing "a new function" at pages 4, 7, 8 and 13 usually does not clearly distinguish between the unexpected results of a sharper, straighter, more uniform bend without marring produced by the flat top hinge structure of the Marsh brake and the theory or theoretical analysis as to how or why such unexpected results are produced. This lack of clarity tends to create the unwarranted inference that such unexpected results were not fully disclosed in the Marsh patent and the proceedings in the Patent Office thereon. The Marsh patent expressly points out that with its specific flat top "hinge construction, an accurate bend is applied to the sheet metal without marring the surface of any coating on the sheet metal" (Marsh patent, Col. 2, L. 12-14). Moreover, these unexpected re-

sults were actually demonstrated to the Patent Office Examiner in charge of the Marsh application before the Examiner allowed claim 7 now in issue. During the demonstration, samples of sheet metal were actually bent on models of the prior art Rauen type brake with a separate round top piano hinge and the Marsh brake with an integral flat top hinge [R. 133-139, and File Wrapper of the Marsh patent (PX-5) at pages 21, 22 and 26]. In allowing claim 7, the Examiner implicitly acknowledged having observed the demonstration and the unexpected results produced by the Marsh brake saying in part:

> "At the recent demonstration of applicant's brake, it was impressed upon the Examiner that the new and unobvious results were obtained,..." (File Wrapper of the Marsh Patent quoted in part at A. 8a).

Thus, the unexpected results produced by the flat top hinge construction of the Marsh patent were pointed out in both the record of the Patent Office proceedings and in the Marsh patent itself and hence were not new thoughts injected at the trial by Dr. Youngdahl's* testimony as inferred by the Petition at page 8.

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* Respondent's expert, Paul F. Youngdahl, received his Bachelor, Master and Doctor degrees in Mechanical Engineering from the University of Michigan where he is a Professor of Mechanical Engineering, teaching courses in Machine Design. Dr. Youngdahl is a registered Professional Engineer, industrial consultant, and for more than 9 years, was the Director of Research and Design of a company which custom designs and builds conveyors and manufacturing machinery. Dr. Youngdahl has previously worked on several patent matters and at the time of trial, was on sabbatical leave working at the University of California in Berkley under a Ford Foundation grant developing a case study method for teaching machine design. Dr. Youngdahl is a member of the American Society of Mechanical Engineers, the American Association for Engineering Education, American Association for the Advancement of Science and the Michigan and National Societies of Professional Engineers (R. 26-31).

C. Dr. Youngdahl's Testimony

In uncontroverted testimony, Dr. Youngdahl testified that the brake of the Marsh patent produces a sharper, straighter, more uniform right angle bend in coated aluminum sheet metal than the prior art Rauen type brake with a separate round top piano hinge (R. 254, 256-258). Contrary to the implication at page 8 of the Petition, this testimony was based on and supported by uncontroverted tests in which Dr. Youngdahl actually used both the prior art Rauen type bending brake with a separate round top hinge (PX-18; R. 252) and the Marsh brake with a flat top hinge (PX-19; R. 252) to make right angle bends in flat painted sheets of aluminum coil stock (PX-16; R. 242 and -17; 245 respectively). Dr. Youngdahl offered to repeat these tests in open court for the benefit of the District Judge and Petitioners' counsel who declined the offer (R. 254-255).

Dr. Youngdahl also theorized that these unexpected results were produced by the Marsh brake because the integral projections of the flat top hinge more closely confined and supported the metal as the bending member approached the top or vertical position to take the kinks out of the sheet metal during the final portion of the bending process (R. 236-242, 271—quoted in part by the Court of Appeals at A. 4a-6a). Dr. Youngdahl also theorized that the Rauen type brake produces an inferior bend because the separate round top piano hinge leaves a groove or a gap between the clamping and bending members which results in less support and confinement of the sheet metal during the final portion of the bending process as the bending member approaches the vertical position (R. 236-242, 271). In presenting this theoretical explanation of the unexpected improved results, Dr. Youngdahl sketched a

free hand diagram on the blackboard which initially included the inaccuracy referred to at pages 7 and 8 of the Petition. On direct examination and without any prompting from counsel, Dr. Youngdahl noted and corrected this inaccuracy in his free hand diagram and indicated that his theoretical explanation was still applicable (R. 261-263), long before being cross-examined thereon by Petitioners' counsel. In discussing this inaccuracy on cross-examination, Dr. Youngdahl emphasized that his theory was only applicable to the final portion of the bending process as the bending member approached the vertical position (R. 271; A. 6a).

D. Demonstration by Petitioners' Counsel

At the close of the trial after Dr. Youngdahl was excused by the District Court and no longer available as a witness, having left to return to California, Petitioners' counsel made some bends in flat sheet metal using the Marsh brake (PX-19; R. 252) and the prior art Rauen type brake (PX-18; R. 252) which were observed by the District Court at the request of Petitioners' counsel (R. 358-368). On the basis of these bends, Petitioners' counsel argued to the District Court that Dr. Youngdahl's theoretical analysis was incorrect and should not be believed (R. 365). Respondent's counsel immediately objected to this argument pointing out to the District Court that these were only *partial* bends illustrating only the beginning of the bending process, and therefore, were not inconsistent with Dr. Youngdahl's theoretical analysis of what occurs in the final portion of the bending process as the bending member approaches the top or vertical position (R. 367). It is uncontroverted and was not denied by Petitioners' counsel that these were only *partial* and not *complete*

bends. The fact that these were only partial bends was not established by sworn testimony because Petitioners' counsel was not a sworn witness subject to cross-examination. Since Petitioners had the burden of proof on this question, it was not incumbent on Respondent's counsel to conduct further demonstrations as contended in the Petition at pages 4 and 5. Moreover, whether Dr. Youngdahl's theoretical analysis was correct does not affect his uncontroverted tests (R. 254-258) in which he made complete right angle bends showing the unexpected results produced by the flat top hinge structure of the Marsh patent.

E. The District Court Opinion

A perusal of the District Court's opinion demonstrates that it failed to apply the correct legal test for patentability of *Graham v John Deere*, 383 US 1 (1966), and to make the probing inquiries and detailed factual analysis required thereunder. The District Court did not give any detailed consideration to the prior art or make any determination of the scope and content thereof, rather it merely referred very briefly to two of the prior art patents (A. 27a). Similarly, the District Court merely quoted portions of the claims in the Marsh patent (A. 24a-25a) rather than making the detailed analysis of the differences between the prior art and the subject matter defined by the claims as required by *Graham*. Moreover, the District Court failed to determine the level of the ordinary skill in the pertinent art.

The District Court also failed to apply the correct legal test in attempting to determine whether the claims of the Marsh patent reasonably defined the structure of the flat

top hinge as required by 35 U. S. C. 112. When the finding relied on by Petitioners as to Dr. Youngdahl's theory is read in context (A. 29a-30a), it is evident that the District Court was trying to determine as a matter of law whether the claims reasonably defined the structure of the flat top hinge as required by 35 U.S.C. 112. Since claims must define structure, not theory, this finding is totally irrelevant to whether the claims comply with 35 U.S.C. 112. Hence, this finding is not subject to the usual "clearly erroneous" criterion since the District Court applied the wrong legal criteria in making such finding.

F. The Opinion of the Court of Appeals

The Court of Appeals in its opinion implicitly agreed that the District Court neither applied the correct legal test for patentability laid down by this Court in *Graham v John Deere* nor applied the correct legal test under 35 U.S.C. 112. Thus, the Court of Appeals in its Opinion carefully applied the correct legal test of *Graham* and thoroughly evaluated all of the evidence of record in holding the Marsh patent valid and infringed.

The Court of Appeals found that the pertinent prior art was the broad category of "machine design" (A. 13a) and, after fully probing and meticulously analyzing the prior art, found that the difference between the prior art references and the brake defined by claim 7 of the Marsh patent was the flat top hinge structure with intermeshed projections, each having a flat top surface in the plane of the flat surface of its corresponding bending and clamping members providing a sharper, straighter, more uniform bend in sheet metal without marring (A. 11a-14a). The Court of Appeals also found that such a flat top hinge structure producing these unexpected results was

beyond the level of ordinary skill in the pertinent art and thus concluded that claim 7 of the Marsh patent defines unobvious subject matter (A. 13a-14a).

Contrary to the assertion at pages 12 and 13 of the Petition, the Court of Appeals, in so holding, merely noted that under its prior decisions Petitioners may have been foreclosed from challenging the utility of such unexpected results produced by the flat top hinge structure and then proceeded to fully evaluate the evidence on this issue and determine whether Petitioners sustained their burden of proof (A. 15a-18a). The Court of Appeals found that "there is no testimony in the record to refute Dr. Youngdahl's theories" (A. 7a), gave little weight to the bends made by Petitioners' counsel "who was not sworn as a witness and did not qualify as an expert" ((A. 17a), and held that "the unsworn, self-serving statements of [Petitioners'] counsel are not evidence". (A. 18a). The Court of Appeals also found that "since Dr. Youngdahl's testimony was directed to the 'critical' final stage as the bend approached the vertical, the demonstration by defense [Petitioners'] counsel, which embodied only partial bends, logically cannot credit nor discredit Dr. Youngdahl's testimony" (A. 16a). Thus, the Court of Appeals found that Petitioners failed to sustain their burden of proof, and that the District Court's finding was "clearly erroneous" since there simply was not any credible evidence in support thereof. Particularly, since Petitioners did not accept Dr. Youngdahl's offer to reconduct in open court the tests on which his testimony was based (R. 254, A. 17a).

G. The Order on Petition for Correction and Rehearing

In moving for a rehearing, Petitioners expressly argued in the Court of Appeals, as they do in this Court, that the District Court's finding was not "clearly erroneous" and, thus, should not be reversed. The Court of Appeals fully evaluated and rejected this argument emphasizing that it had previously said in its Opinion that Petitioners "had full opportunity to offer evidence to refute the testimony of Dr. Youngdahl, but they failed to do so", that the partial bends made by Petitioners' counsel "should have been made as part of the cross-examination of Dr. Youngdahl, or at least could have been supported by sworn testimony of witnesses with the right of plaintiff [Respondent] to cross examine", and that "the unsworn self-serving statements of counsel are not evidence" (A. 20a-21a). The Court of Appeals also emphasized that, as Petitioners "apparently recognize the burden of proving invalidity rested upon them" (A. 21a) and implicitly concluded as a matter of law that Petitioners failed to sustain their burden of proof on this issue and that the District Court's finding was unsupported by any evidence and thus "clearly erroneous".

For the first time Petitioners also contended that it was "physically impossible" for the flat top hinge of the Marsh brake to support the sheet metal during bending. In support of this contention, Petitioners for the first time asked the Court of Appeals to view and demonstrate to itself the Rauen type and Marsh brakes and to examine photographs, taken after its decision was announced, of an *ex parte* demonstration of bending sheet metal on these brakes. The Court of Appeals declined to do so since there is no authority permitting "*ex parte* experiment or demonstration after the case had been argued and decided", Petitioners made no request "for permission to conduct

a demonstration . . . prior to our decision of the case" and the photographs "are not in evidence in the case and cannot be considered by us" (A. 20a). Contrary to the contention at pages 4, 5, 7, 8, 9, 10, 12, 13 and 14 of the Petition, the Court of Appeals certainly did not err in refusing to view and operate the bending brakes in the absence of both parties and counsel since Petitioners failed to ask the Court of Appeals to do so before it decided this cause. Also, there is no support whatsoever in the record for the contention at pages 4, 11, 12 and 14 of the Petition that it is "physically impossible" for the flat top hinge structure to support the sheet metal during bending.

III. REASONS WHY THE PETITION FOR WRIT OF CERTIORARI SHOULD BE DENIED

This is a common, ordinary, garden variety patent infringement suit which does not have any substantial impact on any large industry or any substantial portion of the Commerce of the United States because the Marsh brake is sold in competition with other sheet metal bending devices including the Rauen brake manfactured by Lyf-Alum, Inc. (R. 338-339) and because as found by the Court of Appeals infringement of the Marsh patent can be readily avoided since the claims are very narrow and specific. (A. 9a-10a). Moreover, Petitioners do not seek review of any questions of substantive Federal Patent Law whatsoever and there are no conflicting Court of Appeals decisions involving either the Marsh patent or the question presented for review by this Petition for Writ of Certiorari. Therefore, granting of this Petition will not result in the consideration of any important, unsettled or conflicting questions of patent law or Federal Rules of Civil Procedure, or of any issue of paramount public importance or of substantial effect on commerce.

At most, Petitioners simply seek a review of a specific application by a Court of Appeals of a settled, established, well-known, and widely accepted Rule of Federal Civil Procedure that "findings of fact shall not be set aside unless clearly erroneous". Since any determination of this question is completely dependent on and intertwined with the specific facts of this patent infringement suit, a resolution thereof by this Court would have little, if any, value as a precedent for guiding the future decisions of the Courts of Appeals. Moreover, the Court of Appeals in its Order on Rehearing expressly reviewed its own application of Rule 52 and, thus, Petitioners merely seek reconsideration thereof by this Court. Therefore, granting of this Petition for Writ of Certiorari will not lead to the resolution of any important or unsettled questions of Federal Procedure or result in a decision having any substantial impact on the judicial administration of the jurisprudence of the United States.

As discussed in detail hereinafter, a perusal of the Opinion and the Order on Rehearing of the Court of Appeals will demonstrate "beyond a shadow of a doubt" that rather than departing from the accepted and usual course of judicial proceedings, the Court of Appeals strictly followed both the rules of evidence and procedure applicable in this cause and the strict requirements for patentability laid down by this Court in *Graham v John Deere.* In short, the applicable statutory and case law make it evident that the Court of Appeals would have been remiss in its duty if it had not exercised its own supervisory power in reversing the District Court and certainly has not pursued a course of action warranting the exercise of this Court's power of supervision.

The District Court's finding is "clearly erroneous" and was properly disregarded because as the Court of Appeals

clearly found there was no credible evidence in support thereof. The underlying assumption of the main argument of the Petition is that the bends made by Petitioners' counsel showed that the sheet metal is unsupported and, therefore, conflicted with and tended to refute Dr. Youngdahl's theoretical explanation of the unexpected results of an improved bend without marring produced by the Marsh brake. This underlying assumption is utterly without any basis in the record and such lack of evidence is implicitly admitted by the attempted use of the subsequently taken photographs in the Petition for Correction and Rehearing.

Under well established rules of evidence the argumentative, unsworn, self-serving statements and observations of Petitioners' counsel is not evidence and "as counsel's ipse dixit it is valueless": *Contour Saw, Inc. v. L. S. Starrett Co.* 128 F2d 314, at 317 (5th Cir. 1971) rehearing denied—F2d —, 166 USPQ 1 (1970). Hence, the District Court committed reversible error in relying so heavily on the bends of Petitioners' counsel. Moreover, as the Court of Appeals found (A. 17a), the well-established rules of evidence do not sanction giving more weight and credibility to the unsworn statements and demonstrations of Plaintiffs' counsel who is not qualified as a technical expert than to the sworn testimony based on actual tests of Dr. Youngdahl who is a fully qualified technical expert with many years of teaching, consulting and supervisory job experience in the pertinent art of mechanical machine design and who is a registered Professional Engineer (R. 26-31). Finally, it is the well-established statutory (35 U.S.C. 282) and case law that issued patents are presumptively valid and Petitioners had the burden of proving with clear and convincing evidence that the brake of the Marsh patent did not produce the unexpected results

of a sharper straighter more uniform bend without marring. Therefore, the Court of Appeals was fully justified in finding as a matter of law that Petitioners did not sustain their burden of proof and that the District Court's finding was "clearly erroneous" since it was not supported by and credible evidence and was refuted by the testimony of Dr. Youngdahl. Hence, the District Court committed reversible error in holding the Marsh patent invalid. This conclusion is particularly justified since Petitioners failed to accept Dr. Youngdahl's offer to reconduct in open court his tests (R. 254, A. 17a), and also failed to accept the continuance or stay of trial offered by the District Court (R. 249) for preparation of evidence refuting Dr. Youngdahl's testimony.

Moreover, it is evident from the District Court's opinion that it committed reversible error by failing to apply the correct legal test of patentability under 35 U.S.C. 103 laid down by this Court in *Graham v John Deere*, including failing to make the probing factual inquiries and detailed analysis required thereunder. It is also self-evident that the District Court failed to comprehend and apply the correct legal test of 35 U.S.C. 112 when making the finding now relied on by Petitioners. Since the District Court failed to apply the correct legal standards or tests, its finding is not subject to or controlled by the "clearly erroneous" criterion of Rule 52 of the FRCP: *Toro Mfg. Corp. v Jacobson Mfg. Co.* (CA7th, 1966) 357 F2d 901, 903; *Tidewater Patent Dev. Co. v. K. M. Kitchens* (CA 4th, 1966) 371 F2d 1004, 1006, cert. denied (1967) 389 US 821. Thus, the Court of Appeals was fully justified in reversing the District Court for failure to apply the correct legal standards and in fully evaluating all of the evidence of record.

The contention at pages 4, 11, 12 and 14 of the Petition that it is "physically impossible" for the flat top hinge structure of the brake of the Marsh patent to support the sheet metal during bending is utterly without any support whatsoever in the record. This is simply an afterthought which was baldly asserted by Petitioners' counsel for the first time in the Petition for Correction and Rehearing and was properly rejected by the Court of Appeals since it was not supported by any evidence in the record of this cause (A. 20a). Likewise, the assertion at pages 9 and 13 of the Petition that the Court of Appeals only considered the direct and ignored the cross-examination testimony of Dr. Youngdahl is without merit since the Opinion quotes and analyzes his cross-examination testimony at A. 6a-7a.

The contention at pages 4, 7, 8 and 11 of the Petition that the patent claims, patent specification, Patent Office records, and the inventor did not disclose the "function" or theory that additional support is provided for the sheet metal by the flat top hinge structure of the Marsh patent is totally irrelevant as a matter of law. Similarly, the contention that the inventor developed the flat top hinge structure of the brake of the Marsh patent without appreciating the theory of additional support provided during the final portion of the bend is totally irrelevant as a matter of law. These contentions were fully and correctly evaluated by the Court of Appeals in its Opinion when it said at A. 18a that:

The Statute provides:

> "Patentability shall not be negatived by the manner in which the invention is made." 35 U.S.C. 103.

Nor do the statutes require that an inventor understand and disclose the theory of his invention. He is entitled to all of the benefits of his invention even though they were greater than he believed. Dellers Walker on Patents, 2d Ed., Vol 4, §283, pp. 106, 107.

These contentions are particularly irrelevant here since the Marsh patent fully discloses and describes the flat top hinge structure and specifically points out that such structure provides an improved bend without marring and the claim in issue narrowly and specifically defines the flat top hinge structure. As this Court stated in *United States v Adams,* 383 US 39, 49 (1966) "it is fundamental that claims are to be construed in the light of the specifications and both are to be read with a view to ascertaining the invention".

Petitioners erroneously contend at pages 12 and 13 of the Petition that they were barred from challenging the utility of an improved bend without marring. Rather a perusal of the Opinion of the Court of Appeals at A. 15a-18a demonstrates that it merely noted that under its prior decisions Petitioners may have been so barred and then proceeded to fully evaluate all of the evidence and materials presented on this issue. Moreover, it is conceded at page 13 of the Petition that "this point need not be considered in this Petition, . . .". Furthermore, it is submitted that this issue is not fairly comprised in the question presented for review as required by Rule 23.1 (c) of this Court and therefore, is not properly before this Court.

It ill behooves Petitioners to contend at pages 4, 5, 12 and 13 of the Petition that the Court of Appeals erred by not examining and demonstrating for itself the Rauen and Marsh type sheet metal bending brakes when Peti-

tioners utterly failed to ask the Court of Appeals to do so before it handed down its Opinion in this cause. As noted by the Court of Appeals, Petitioners did not even request permission to demonstrate the brakes at the oral argument on appeal (A. 20a). Certainly, it was not error or an abuse of discretion for the Court of Appeals to refuse to do so in connection with the Petition for Correction and Rehearing where neither the parties nor counsel would be present during such a demonstration. In fact it would have been highly "unorthodox" (A. 20a) for the Court of Appeals to go outside of the record in this cause and independently experiment with and perform tests on the Rauen and Marsh type bending brakes. There is no case or statutory law sanctioning such a procedure. To allow Petitioners to retry this case piecemeal by requiring the Court of Appeals to conduct for itself such demonstrations at this late date as urged on page 14 of the Petition would obstruct orderly judicial procedure and be a travesty of justice. Petitioners have had their day in court and orderly judicial administration requires that this cause be terminated; particularly since Petitioners have not shown that such demonstrations could not have been performed either at the trial or hearing on Appeal and Petitioners declined the District Court's offer to grant a continuance for such purpose (R. 249).

IV. CONCLUSION

For the above reasons this Petition for Writ of Certiorari should be denied.

Respectfully submitted,

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1971

Docket No. 71-449

VAN MARK PRODUCTS CORPORATION and
EUGENE VAN CLEAVE,
Petitioners,
vs.
TAPCO PRODUCTS COMPANY,
Respondent.

PETITIONERS' SUPPLEMENTAL BRIEF

Pursuant to Rule 24(5), Petitioners call to the Court's attention a relevant "intervening matter" which arose *after* the filing of the Petition for Writ of Certiorari. More specifically, the Court's attention is directed to the District Court's recent "Finding Modifying Injunction to Conform with Sixth Circuit Court of Appeals' Decision", dated October 21, 1971 (see attached Supplemental Appendix, p. 1b).

The "intervening matter" arose as follows:

The Sixth Circuit Court of Appeals issued its mandate to the District Court on September 23, 1971. Then Plaintiff (Respondent here) presented to the District Court, ex-parte, a Judgment and Writ of Injunction. The Judgment was entered on September 27, 1971 (Supplemental

Appendix, p. 14b) and the Writ of Injunction was entered on October 1, 1971 (Supplemental Appendix, p. 17b).

On October 7, 1971, Defendants (Petitioners here) moved for an Order modifying the Judgment and Writ of Injunction (Supplemental Appendix, p. 11b). Hearing on this Motion, including the taking of the testimony, was held on October 18, 1971.

The District Court granted this Motion and entered its "Order Modifying Judgment" on October 21, 1971 (Supplemental Appendix, p. 10b), along with its above mentioned "Findings" (see Supplemental Appendix, p. 1b).

Respondent's Brief in Opposition to the Petition, served on October 28, 1971, makes no mention of and contains no reference to the above matter, nor to such "Findings".

The relevance of these recent "Findings" to the Petition is that the very witness, Youngdahl, upon whose testimony the Court of Appeals solely relied in reversing the District Court, now validates the District Court's original (reversed) Finding of no new function.

At trial, the District Court faced the choice of believing Plaintiff's expert Youngdahl's oral testimony that there was a new function* or believing what the Court personally observed during a Courtroom demonstration of the patented bending brake, namely, no new function (i.e., no hinge support during bending). The District Court resolved the conflict by adopting its own observations and rejecting the conflicting testimony of the witness.

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* The Court of Appeals summarized Youngdahl's testimony (see Petition Appendix, p. 16a) as follows: "The thrust of Youngdahl's testimony was that great additional support was given by the hinge during bending, particularly in its final stage."

The Court of Appeals reversed, resolving the conflict by adopting Youngdahl's testimony and rejecting the District Courts' observations.

Now, at the Hearing on the above Motion to modify the Injunction, Youngdahl eliminated the conflict altogether, by agreeing with the District Court's original Finding of no new function, that is, by now testifying and demonstrating that the Marsh patent brake hinge does *not* support the sheet metal at any time during bending, including at the final stage (see District Court's Finding, attached Appendix, p. 9b).

We submit that this corroborates Petitioner's contention raised by the Petition, namely, that the Court of Appeals erred under Rule 52(a) in substituting its Judgment for that of the District Court, as to the weight to be given the Trial Testimony of Youngdahl and in reversing the District Court's Finding of no new function.

Respectfully submitted,

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Dated: November 2, 1971

SUPPLEMENTAL APPENDIX

IN THE

District Court of the United States

For the Eastern District of Michigan
Southern Division

Tapco Products Company,
Plaintiff,

vs.

Van Mark Products Corporation and Eugene Van Cleave,
Defendants

Civil No. 31627

FINDINGS MODIFYING INJUNCTION TO CONFORM WITH SIXTH CIRCUIT COURT OF APPEALS' DECISION

The matter before the Court at this time is Defendant's Motion to Modify the Judgment entered September 27, 1971 and the Writ of Injunction issued by this Court pursuant thereto, on October 1, 1971. Defendants contend that the Writ of Injunction departs from the recent Court of Appeals' Opinion of July 12, 1971 concerning this case and that because plaintiff has used such Writ of Injunction in customer contacts as a sales tool, the Writ of Injunction should be clarified as to what defendants are permitted to make and sell, as well as what is restrained. In accordance with the facts found below, this Court agrees and grants the Motion.

As background to this Motion: Following the initial trial, this Court found claims 1-7 of Plaintiff's Marsh Patent No. 3,161,223 invalid for "obviousness" over the prior art (see Opinion dated July 28, 1970). At that time, this Court made no Findings as to the subject of infringement, the same not appearing to be necessary under the circumstances. Plaintiff appealed as to Claim 7 only, and the Court of Appeals for the Sixth Circuit reversed, finding Claim 7 valid and infringed. (See Opinion dated July 12, 1971). The case was remanded for further proceedings by this Court. Accordingly, this Court entered the above Judgment, which was presented to it by plaintiff and which is the subject of the present Motion.

Relevant to this Motion, the Court of Appeals found Claim 7 to be valid, because the flat topped integral hinge of the Marsh patent brake supports the sheet metal during bending, particularly at the full 90° bend, thereby producing a better bend than the prior art brake round topped piano-type hinge which was separately fastened by screws or bolts. The Court of Appeals agreed with this Court that the integral hinge itself was "obvious" and not patentable, but found invention in that:

> "Plaintiff has combined the old art piano-type integral hinge with a new type *'flat, gapless' hinge* not known to the prior relevant art in such a way as to create a new, better and unsuspected result. *The Marsh hinge provides greater support* and prevents the sheet metal from slipping into a 'gap' and thus prevents non-uniformity and marring." [Emphasis added].

The Court of Appeals further stated:

> ". . . it seems fairly clear that if there is no functional improvement made by the flat-topped hinge,

> then the mere use of an integral piano-type hinge would be obvious and it was so considered by the Patent Examiner. If, however, the flat-topped hinge is a functioning improvement to the prior art then it would be patentable . . . "

Thus, the nub of patentability was the Court of Appeals finding, reversing the Finding of Fact of this Court, that the flat topped hinge supports the sheet metal during bending. The Court of Appeals based its Finding of hinge support solely upon the testimony of plaintiff's expert witness, Dr. Youngdahl. After quoting testimony of Youngdahl to the effect that the Marsh patent brake hinge supports the sheet metal during bending, the Court of Appeals summed up his testimony as follows:

> "The thrust of Youngdahl's testimony was that great additional support was given by the hinge during bending, particularly in its final stage . . . "

In adopting the testimony of Professor Youngdahl for the basis of its findings, the Court of Appeals ignored the fact that this Court, as the finder of fact, is the sole judge of the weight to be given to the testimony of an expert witness. Moreover, the Appellate Court also ignored the fact that this Court had placed great reliance on the courtroom hinge demonstrations which it had personally observed. After viewing the demonstrations of the hinges, this Court, unlike the Reviewing Court, gave little weight to Younghahl's testimony, or to the findings of the professor's out-of-court tests. Youngdahl's testimony was, in short, contrary to what this Court observed.

So much for the background; this Court must, and here does, follow the Court of Appeals' opinion. The Court notes, however, that the testimony and demonstrations

in connection with this Motion clearly show that in the operation of the Marsh brake hinge, just as in the case of the prior art brake, the hinge does *not* support the sheet metal during bending.

Having found validity, the Court of Appeals clearly delineated the scope of the patent claim first, by references to the fact that the Patent Office "Examiner allowed Claim 7 *only* because it described the top surface of the hinge as being flat and lying within the plane of the corresponding member surfaces". Thus, the Court of Appeals' Opinion instructs this Court that the patent claim covers only hinges whose top surfaces are both flat and lie within the plane of their corresponding members.

Second, the Court of Appeals specified those hinges which are excluded from the scope of the patent claim in the following statement:

> "Defendants could easily have avoided liability by choosing any one of many alternatives to copying the Marsh brake. Among these alternatives, Defendants could have continued to use the prior art Rauen brake; they could have welded a Rauen-type hinge onto the members for greater hinge stability; or they could have used an extruded integral hinge of any design which did not adopt Plaintiff's teaching to position the surface of the hinge projections flush with the plane of their corresponding member surfaces."

Thus, rounded top hinges, as were used in the prior art Rauen brake, even if extruded integral are excluded from the patented Claim 7.

Third, the Court of Appeals made it plain that the patented invention was confined to hinges which do in fact

function to support the sheet metal during bending, since in the absence of that function, the Court of Appeals stated that the hinge would be unpatentably "obvious".

Defendants' Motion asks this Court to follow the Court of Appeals' opinion and pursuant thereto modify the Injunction against making or using or selling structures defined in Claim 7 by adding words to the effect that the Injunction does not apply to and does not prohibit the manufacture or sales or use by defendants or their customers of bending brakes whose hinge projections do not support the sheet metal during bending, nor to bending brakes whose hinge projections top surfaces are not flat and gapless, or not lying in the plane of the upper surfaces of their corresponding members.

In support of their Motion, defendants offered the courtroom testimony of defendant Van Cleave, an officer of defendant Van Mark, and also offered the testimony of Professor Youngdahl who was subpoenaed as an adverse witness. Van Cleave testified as to plaintiff's use of the present writ of injunction as a "sales weapon" as demonstrated by a statement plaintiff made to one of defendant's principal customer's alleging that defendants are prohibited by Court injunction from selling any bending brakes.

In the opinion of this Court Mr. Van Cleave's testimony demonstrates the need of judicial intervention for purposes of clarifying this Court's injunction and in order to clearly inform laymen-customers that only certain brakes are prohibited as a result of the finding of infringement. The decision of the Sixth Circuit Court of Appeals clearly entitles the defendants to sell, and the public is entitled to buy, brakes which are outside the scope of the patented Claim 7.

Van Cleave also demonstrated six bending brakes to this Court, including three recent models of the defendants, which are as follows: The first (Exhibit A) has flat-topped hinges but with a plastic strip positioned on the outboard edge of the bending member so that the hinge tops are not in the plane of said bending member.

The second (Exhibit B) and third (Exhibit C) each have the same plastic strip, but the second has one set of integral hinge projections rounded, rather than flat, and the third has both sets of integral hinge projections rounded. Van Cleave operated these brakes for the Court and demonstrated to the Court that in none of these brakes do the hinge projections support or contact the sheet metal at any time during bending, including at or near the final stage of the bend. Youngdahl agreed with Van Cleave, repeating the brake operation demonstrations for the Court, and agreeing that none of these brakes embody the inventive hinge support of the sheet metal during bending and that none include the flat topped hinge surfaces lying in the planes of their corresponding members. Thus, the Court finds these brakes to be outside the scope of patent Claim 7 and finds that they do not utilize the patent invention, having neither the hinge support function, nor flat hinge tops lying in the planes of their corresponding members.

Van Cleave further operated and demonstrated to the Court that the brakes of Trial Exhibits 4 (defendant's brake), 18 (the prior art piano-type hinge brake) and 19 (the Marsh patent brake). He demonstrated and testified, and this Court took special care in observing this, that in none of these brakes do the hinges support the sheet metal at any time during bending, including at or near the final stage of the complete 90° bend. In short, he demon-

strated, and the Court so finds, that in all the physical exhibits, Nos. 4, 18 and 19, as well as the above Hearing Exhibits A, B, and C, the hinges function in exactly the same way during the bending operation, that is, at all times each of the hinges of each of the Exhibits are well spaced away from and do not contact or support the sheet metal at any time during the bending up to and including the final stage and that all operate like the prior art piano hinge brake of Exhibit 18 with respect to neither contacting nor supporting the sheet metal during bending.

He demonstrated, and the Court finds, that the sharpness and straightness of the bend in all of the above brakes, regardless of the hinge style or shape, depend upon the sharpness and straightness of the anvil edge about which the metal is bent, and are not dependent upon the shape or style of the hinge. Van Cleave further testified, and this Court finds as fact, that the utility of the integral hinges which defendants use are their strength, appearance, avoidance of screws and bolts, and ease of assembly. None (i.e. the hinges) support the sheet metal during bending.

This Court also heard and observed the Courtroom testimony and demeanor of Professor Youngdahl. His testimony initially seemed to confiict with that of Mr. Van Cleave, which the Court felt was credible and convincing. However, the Court is of the opinion, and so finds, that Professor Youngdahl's objections and exceptions to the hinge demonstrations were unconvincing, and more important, irrelevant to the patent claim and concept that forms the subject of this litigation.

This Court does not rely upon Professor Youngdahl's statements because of what this Court personally observed to be a fact in connection with the physical mani-

pulations of the brakes. More specifically, Youngdahl testified that the Marsh patent brake, Exhibit 19, does *not* support the sheet metal at any time during bending and that the sheet metal is spaced from the hinge at all times during bending including at the final stage. He made the same statements as to defendants' recent brakes, Exhibits A, B, and C. The Court accepts this testimony and finds this to be fact, because the Court saw this itself, apart from hearing Van Cleave's confirming testimony and demonstrations.

However, Youngdahl also testified that the prior defendants' brake (Exhibit 4) will support the sheet metal at the final stage of bending *if* the anvil is "properly adjusted" relative to the thickness of the particular piece of sheet metal being bent as well as relative to the hinge. Absent such an adjustment, he admitted that the hinge does not support the sheet metal at any time during the bending.

This Court rejects Youngdahl's testimony as to the hinge support *if* the anvil is adjusted relative to the thickness of the sheet metal, first, because none of the brakes have any means for adjusting the anvil relative to the thickness of the sheet metal, which thickness obviously may vary, indicating that no such adjustment is contemplated. Second, *no such adjustment means or concept is found anywhere in the patent or in the patent claim.* Third, the geometry of the brake parts, meaning the location of the hinge relative to the anvil edge, bending member and clamping or table member precludes such hinge support of the sheet metal, in a normal or commercial brake construction. Thus this Court finds from the testimony and its observations that Youngdahl's theory of anvil adjustment is irrelevant and rejects his testimony.

Having observed again the operation of the Marsh patent brake (Exhibit 19), this time demonstrated by Van Cleave, and personally seeing again that at no time does the hinge support the sheet metal during bending and that at all times, including at the final stage of the full bend of 90°, the hinge is well spaced from the sheet metal, and having heard even Youngdahl now admit this to be true, and having observed Youngdahl demonstrate this to be true, this Court cannot help but find that the Marsh patent hinge does not operate or function any differently than the prior art brake hinge with respect to the relevant absence of hinge support during bending.

Nevertheless, the Court of Appeals having found the patent valid because of the inventive hinge support, this Court must and hereby does follow its mandate. However, fairness and equity to the defendants,* as well as to the public which is entitled to have available to it bending brakes which are not within the scope of a valid patent claim, see *Lear v. Adkins,* (1969) 395 U.S. 653, requires this Court to modify the Writ of Injunction and the Judgment to specifically exclude therefrom any brakes of defendants wherein the hinges do not support the sheet metal during bending or wherein the hinge projection tops are not flat and do not lie within the plane of the corresponding brake members.

Thus, defendants' Motion is granted. This Opinion shall be considered as the Findings of this Court made in accordance with Rule 52(a) F.R.C.P.

Fred W. Kaess
United States District Judge.

Dated: October 21, 1971.

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* Rule 60 (B) (5) and (6) F.R.C.P.

ORDER MODIFYING JUDGMENT

At a session of said court held in the Federal Building in the City of Detroit, Michigan, on the 21st day of October, 1971.

Present: The Honorable Fred W. Kaess, United States District Judge.

On hearing before this Court on October 18, 1971, on defendants' Motion for Modification of Judgment and Writ of Injunction, the Court having heard oral testimony and having observed demonstrations of and heard oral testimony regarding the operations of defendants', plaintiff's and prior art brakes, and having heard oral argument by counsel, and having found that the Writ of Injunction entered October 1, 1971, has been shown by plaintiff to defendants' customers and therefore should be modified to clarify the scope of the Injunction to better conform to the opinion of the Court of Appeals for the Sixth Circuit entered July 12, 1971, and having further found that none of defendants' brakes, past as well as present ones, include hinges whose tops support the sheet metal at any time during bending, and that none of defendants' present model brakes include hinges which are both flat and lie in the plane of their corresponding members and hence, do not embody the invention of Patent No. 3,161,223, Claim 7-in-suit;

It is Hereby Ordered:

1. Defendants' Motion for Modification of Judgment and Writ of Injunction is hereby granted.

2. The Writ of Injunction entered October 1, 1971, and the Judgment entered September 27, 1971 are hereby modified by adding the following clause thereto:

"This injunction does not apply to and does not prohibit the manufacture or sales or use by Defendants or their customers of bending brakes whose hinge projections do not support the sheet metal during bending, nor to bending brakes whose hinge projection tops are not flat, gapless and lying in the planes of the upper flat surfaces of their corresponding member."

Fred W. Kaess
United States District Judge

DEFENDANTS' MOTION FOR MODIFICATION OF JUDGMENT AND WRIT OF INJUNCTION AND BRIEF IN SUPPORT

Defendants hereby move for modification of the Judgment entered September 27, 1971, and the Writ of Injunction issued October 1, 1971, by adding the following clause thereto:

"This injunction does not apply to and does not prohibit the manufacture or sales or use by Defendants or their customers of bending brakes whose hinge projections do not support the sheet metal during bending, nor to bending brakes whose hinge projections are not flat, gapless, flush and integral with the flat tops of the surfaces of their corresponding members."

LOCAL RULE 9

Defendants' counsel have asked Plaintiff's counsel to agree to the grant of the above motion, but Plaintiff's counsel has refused.

BRIEF IN SUPPORT OF MOTION

The Opinion of the Court of Appeals found that the Marsh patent inventive feature is that the flat, gapless, flush hinge tops support the sheet metal during bending. The Court found that such hinge support of the sheet metal is a "new, better and unsuspected result" and based its finding of validity of Claim 7, the only claim on appeal, upon that idea.

The Court of Appeals specifically found that in the absence of such "utility" (meaning hinge support of the sheet metal during bending), by the flat, gapless, flush hinge feature, the patented claim would be "obvious" and thus not patentable.

Consequently, it is manifest from the Court of Appeals Opinion, that hinges which do not provide such "utility" (hinge support of sheet metal during bending) should be excluded from the scope of the patent and consequently, the scope of the injunction.

In addition, the Court of Appeals expressly exempted from the scope of the patent (and hence from any injunction thereon) any hinges which are round topped (Rauen prior art patent), whether of the integral or screw-on types, or which otherwise are not flush with the corresponding member surfaces.

The Writ of Injunction and the Judgment in this case were presented to the Court without first clearing them with Defendants' counsel. They were not served upon Defendants' counsel or notified to them in any way until October 1, 1971.

As the Court will recognize, the fact of business life is that a Writ of Injunction of this type is a sales weapon

which we can all anticipate will be exposed to customers and potential customers. Since customers are not patent lawyers and are not knowledgeable of the Court of Appeals Opinion, we anticipate customer confusion with reluctance to buy brakes of any kind from Defendants. To avoid such problems, and in fairness to both sides, the Writ of Injunction should clearly spell out that the customers do have the right to purchase and use brakes whose hinges do not support the sheet metal or whose hinges are not flat, gapless or flush. Since that follows the Opinion of the Court of Appeals, the Injunction and Judgment on their faces should be clarified to conform therewith.

The wording of the Writ of Injunction and the Judgment is not academic. Defendant is now selling and offering for sale bending brakes whose hinges have rounded tops which do not support the sheet metal during bending. Thus, the injunction, following the dictate of the Court of Appeals, should on its face notify the public that such type hinges are permissible and that the public is free to purchase and use brakes having hinges which do not support the sheet metal during bending or whose tops are rounded.

Wherefore, we respectfully request this Court to modify the Judgment and the Writ of Injunction in accordance with the Opinion of the Court of Appeals. In support of this Motion, Defendant will offer brief testimony at the hearing as to the relevant facts.

Respectfully,

Cullen, Settle, Sloman & Cantor
By: Bernard J. Cantor
3200 Penobscot Building
Detroit, Michigan 48226
(313) 964-0400
Attorneys for Defendants

PROOF OF SERVICE

A copy of the foregoing was mailed to Barnes, Kisselle, Raisch and Choate, Attorneys for Plaintiff on this 7th day of October, 1971.

Bernard J. Cantor

JUDGMENT

A notice of appeal having been filed in this patent infringement suit on August 28, 1970, the United States Court of Appeals for the Sixth Circuit having decided on July 12, 1971 that claim 7 of Marsh United States Patent 3,161,223 issued on December 15, 1964 on a Sheet Metal Brake is valid and also infringed by defendants, defendant's Petition for Rehearing having been denied on August 30, 1971, and defendants' motion for Stay of Mandate Pending Application for Certiorari having been denied and immediate issuance of the mandate being ordered on September 20, 1971, and there being no just reason for delaying ordering of the following injunctive relief, and such relief having been requested by plaintiff; it is hereby Ordered, Adjudged, and Decreed:

1. This court has jurisdiction over the plaintiff, Tapco Products Company, Inc., which is a Michigan Corporation having its offices and principal place of business at 9240 Hubbell Ave., Detroit, Michigan 48228, over the defendant Van Mark Products Corporation, which is a Michigan Corporation having an office and place of business at 18235 Weaver, Detroit, Michigan 48228 and Eugene Van Cleave who resides at 24530 Lyndon, Detroit, Michigan 48239, and over the subject matter in issue.

2. Tapco Products Company, Inc., is the owner of the entire right, title and interest in and to the Marsh United States Letters Patent No. 3,161,223 issued December 15,

1964 and is entitled to bring suit thereon for patent infringement.

3. That a permanent injunction shall issue out of and under the seal of this Court directed to said defendants Van Mark Products Corporation and Eugene Van Cleave, their officers, agents, servants, employees, attorneys, and all persons, companies, firms, and corporations, claiming by, through, or under such defendants, or either of them, or in active concert or participation with them, or either of them, or under their authority, who receive actual notice thereof, permanently restraining and enjoining defendants and each of them:

(A) From making, using, or selling directly or indirectly, until and including December 15, 1981, brakes for bending sheet metal, or parts thereof intended and designed to be assembled as brakes for bending sheet metal, which are described in claim 7 of said United States Letter Patent No. 3,161,223, and from further infringing claim 7 of said Letters Patent by the manufacture, use, or sale of brakes for bending sheet metal embodying the invention set forth and included in said claim 7, which reads as follows:

> In a brake for bending sheet metal, the combination comprising a first member having a flat clamping surface, an anvil member for clamping a piece of metal against said flat clamping surface on said first member, a second member having a flat bending surface, each of said first and second members having substantially the entire length of the longitudinal edges thereof formed with longitudinally spaced intermeshing integral projections, each said projection of each said member having a surface thereof lying in the plane of the flat surface of its corresponding member, said projections having aligned openings therein, and a hinge

pin extending through said integral projections and thereby defining a hinge so that said second member may be swung relative to said first member to bend said metal about said anvil member.

(B) and from making, using and selling, directly or indirectly until and including December 15, 1981, brakes for bending sheet metal, or parts thereof intended and designed to be assembled as brakes for bending sheet metal, which are exemplified in Plaintiff's Exhibits 4 and 22.

4. That this court retain jurisdiction to determine damages adequate to compensate plaintiff for the infringement of claim 7 of said Letters Patent together with interest as may be fixed by this Court, to determine whether such damages should be increased up to three times the amount found or assessed pursuant to title 35 Section 284, to determine whether reasonable attorney fees should be awarded to plaintiff pursuant to title 35 Section 285, to hear and determine the unfair competition, contract, and other issues alleged in counts II, III, and IV of plaintiff's complaint and to hear and determine all other issues in this case not expressly determined by this Judgment.

5. That the Counterclaim of defendants be and hereby is dismissed with prejudice.

Entered this 27th day of September, 1971.

Honorable Fred W. Kaess
United States District Judge

WRIT OF INJUNCTION

To the defendant Van Mark Products Corporation, a corporation of Michigan having a place of business at 18235 Weaver, Detroit, Michigan 48228, and the defendant Eugene Van Cleave, residing at 24580 Lyndon, Detroit, Michigan 48239, and to their officers, agents, servants, employees, attorneys, and to all persons, companies, firms, and corporations claiming by, through or under such defendants, or either of them, or in active concert or participation with them, or either of them, or under their authority who receive actual notice of this Writ of Injunction.

Whereas, by judgment entered by this court on September —, 1971 it appears that Marsh United States Letters Patent No. 3,161,223, issued December 15, 1964 on a sheet metal brake is valid and infringed by said defendants and by said judgment it was ordered that an injunction issue out of and under the seal of this Court against the defendants restraining against further infringement;

Now, Therefore, we do hereby command and strictly restrain and enjoin you, the said Van Mark Products Corporation, and the said Eugene Van Cleave, and their officers, agents, servants, employees, attorneys, and all persons, companies, firms, and corporations claiming by, through, or under said defendants, or either one of them, or in active concert or participation with them, or either of them, or under their authority who receive actual notice of this Writ of Injunction:

(a) From making, using, or selling directly or indirectly, until and including December 15, 1981, brakes for bending sheet metal, or parts thereof intended and designed to be assembled as brakes for bending sheet

metal, which are described in claim 7 of said United States Letters Patent No. 3,161,223, and from further infringing claim 7 of said Letters Patent by the manufacture, use, or sale of brakes for bending sheet metal embodying the invention set forth and included in said claim 1 which reads as follows:

> In a brake for bending sheet metal, the combination comprising a first member having a flat clamping surface, an anvil member for clamping a piece of metal against said flat clamping surface on said first member, a second member having a flat bending surface, each of said first and second members having substantially the entire length of the longitudinal edges thereof formed with longitudinally spaced intermeshing integral projections, each said projection of each said member having a surface thereof lying in the plane of the flat surface of its corresponding member, said projections having aligned openings therein, and a hinge pin extending through said integral projections and thereby defining a hinge so that said second member may be swung relative to said first member to bend said metal about said anvil member.

(b) And from making, using and selling, directly or indirectly until and including December 15, 1981, brakes for bending sheet metal, or parts thereof intended and designed to be assembled as brakes for bending sheet metal, which are exemplified in Plaintiff's Exhibits 4 and 22.

Which commands and injunction you are respectively required to observe and obey. Hereof fail not, under penalty of the law thence ensuing.

Issued at Detroit, Michigan, this 1st day of October, 1971 in accordance with said Judgment of this Court signed by the Honorable Fred W. Kaess, Judge of the United States District Court for the Eastern District, Southern Division of Michigan, on the 27th day of October, 1971.

Frederick W. Johnson
Clerk
By: E. James Chaffee
Deputy Clerk